SUPREME COURT, U.S.
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No. 02-

IN THE

Supreme Court of the United States

ALBERT R. SPARACO, JR.,

Petitioner,

v.

LAWLER, MATUSKY, SKELLY, ENGINEERS LLP, THOMAS B. VANDERBEEK, NORTHERN METROPOLITAN FOUNDATION, MORRIS KLEIN, DAHN & KRIEGER ARCHITECTS PLANNERS PC and GRAHAM & ALEXANDER,

Respondents.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SECOND CIRCUIT

PETITION FOR A WRIT OF CERTIORARI

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QUESTIONS PRESENTED

The first question is whether the original depiction of a three dimensional terrain in a two-dimensional survey, site plan, plat, other map or technical drawing using such conventional means of expression as lines and known cartographic symbols is protected by copyright.

The second question is whether a contractor/builder infringes a copyrighted site plan when he makes a three-dimensional copy of the site plan's two-dimensional expression of a building footprint, landscaping, sidewalks, driveways, and the like and whether an architect infringes a copyrighted site plan when he use that copyrighted site plan to design a building to fit on the site.

The third question is whether a District Court should be required to vacate the dismissal of an architect and contractor/ builder from a copyright infringement action where later-obtained evidence shows that they are direct infringers and that they committed perjury to secure their dismissal.

PARTIES TO THE PROCEEDING

Petitioner

Petitioner is Albert R. Sparaco, Jr., a land surveyor, who has his principal place of business in Rockland County, New York, a suburb of New York City. The Petitioner is the plaintiff in the District Court and was the appellant and cross-appellee in the Second Circuit Court of Appeals.

Respondents

Respondents are developers Northern Metropolitan Foundation, a not-for-profit corporation of New York and Morris Klein, who have offices in Rockland County, New York; engineers Lawler Matusky, Skelly, Engineers, LLP, a limited liability partnership, and Thomas B. Vanderbeek, with offices in Rockland County, New York; an architect Dahn & Krieger Architects Planners PC, a New Jersey corporation with offices in New Jersey; and a contractor/builder, Graham & Alexander, a partnership located in New Jersey. The respondents are defendants in the District Court. Respondents Northern Metropolitan; Lawler, Matusky, and Vanderbeek were appellees and cross-appellants in the Second Circuit. Respondents Dahn & Krieger and Graham & Alexander were appellees in the Second Circuit.

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Petitioner respectfully petitions for a writ of certiorari to review the judgment of the United States Court of Appeals for the Second Circuit in this case.

OPINIONS BELOW

The District Court's Report and Recommendation (per Smith, M.J.) granting in part and denying in part motions for summary judgment by all Respondents and denying Petitioner's motion for a preliminary injunction (Appendix ("Pet. App.") 79a-105a) was decided May 14, 1999, entered May 17, 1999, and published at 1999 U.S. Dist. LEXIS 22836. The District Court's Decision and Order Accepting in Part and Rejecting in Part the Report and Recommendation of the Hon. Lisa Margaret Smith (per McMahon, D.J.) which granted Respondents Graham & Alexander's and Dahn & Krieger Architects Planners, P.C.'s motions for summary judgment dismissing them from the action, denied Respondents Northern Metropolitan Foundation, Morris Klein, Lawler Matusky, Skelly Engineers LLP, and Thomas Vanderbeek's motions for summary judgment to dismiss them from the action, and granted summary judgment to Petitioner Albert R. Sparaco, Jr., on his claim of breach of contract (Pet. App. 52a-78a) was decided on August 11, 1999, entered August 19, 1999 and published at 60 F. Supp. 2d 247. The District Court's Supplemental Decision and Order (per McMahon, D.J.) denying the motion by Respondents to dismiss the contract action (Pet. App. 49a-51a) was decided September 14, 1999, entered September 16, 1999 and published at 1999 U.S. Dist. LEXIS 23198. The District Court's Decision and Order dismissing the action against Respondents Lawler, Matusky, Skelly Engineers, LLP, Thomas Vanderbeek, Northern Metropolitan Foundation, and Morris Klein (Pet. App. at 21a-48a) was decided August 25, 2000, entered August 31, 2000, and published at 2000 U.S. Dist. LEXIS 22177. The Second Circuit Court of Appeals' opinion (per Leval C.J. joined by Jacobs, C.J. and Katzmann, C.J.) was decided and entered August 29, 2002 (Pet. App. at 1a-20a) and published at 303 F.3d 460. The Second Circuit Court of Appeals'

orders denying rehearing and rehearing en banc were decided and entered October 25, 2002 (Pet. App. at 106a-107a) and are not otherwise published.

STATEMENT OF JURISDICTION

The Second Circuit Court of Appeals entered its opinion and order on August 29, 2002, and denied rehearing and rehearing en banc on October 25, 2002. Petitioner invokes this Court's jurisdiction under 28 U.S.C. § 1254(1).

STATUTORY PROVISIONS INVOLVED

The provisions of the Copyright Act of 1976, 17 U.S.C.:

§ 101 provides, in relevant part:

> As used in this title, the following terms and their variant forms mean the following:
>
> "Pictorial, graphic, and sculptural works" include two-dimensional and three-dimensional works . . . maps, globes, charts, diagrams, models, and technical drawings, including architectural plans. . . .
>
> A "derivative work" is a work based upon one or more preexsiting works, . . . [including] any other form in which a work may be recast, transformed, or adapted.

§ 106 provides, in relevant part:

> [T]he owner of copyright under this title has the exclusive rights to do and to authorize any of the following:
>
> (1) to reproduce the copyrighted work in copies or phonorecords;
>
> (2) to prepare derivative works based upon the copyright works.

STATEMENT OF THE CASE

A. Introduction:

This case is about the rights the owner of a copyright has in a site plan including his/her ability to control what is done with that copyrighted work.

A site plan is a highly technical, complex multiple page set of maps, technical drawings and specifications of existing land and proposed improvements. If followed, developers can build physical improvements to and upon the land that conform to the site plan. When the parcel is large (as, for example in this case, a ten acre parcel) it can (and did) take years to prepare.

A site plan depicts property in two-dimensions, representing how it exists before it is improved. The author surveys the property, makes measurements, selects amongst the measurements, and then transforms the measurements into two-dimensional maps and technical drawings of the three-dimensional property. Like an artist seeking to present a realistic picture, the surveyor uses means of presentation which will be understood by the viewer. These include conventional lining and cartographic symbols. The authors, which include a surveyor, an architect, engineer, and landscape engineer, prepare and draw the improvements into the plan. The site plan also depicts in two-dimensions how the property will appear once developed. The authors create proposed measurements and, based upon these proposed measurements, prepare additional maps and technical drawings to show in two-dimensions all of the improvements to be incorporated within the site plan: the footprint of the building, the changes in grade caused by construction of the site including the building, the utilities, landscaping, and the like. After any required approvals by a municipal government, the site can be built. A site plan then is a plan for development.

In this case, a surveyor had a contract with developers to prepare a site plan. The contract provided that the developers

could copy and build the site plan, including the building whose footprint was created as part of the site plan. The contract barred the developers from amending or modifying the site plan without the permission of the owner/surveyor. The developers expressly agreed that the surveyor owned the copyright in the site plan. This contract was to protect the surveyor's substantial investment and creative effort in the creation of the site plan.

The developers wanted to change the proposed building. In order to avoid paying the surveyor to amend and modify his site plan, the developers had the plan modified by their own contractor/builder, architect, and engineers. Also, without the permission of the surveyor, the infringers built, in three-dimensions, a modified version of the site plan which included replacing the footprint of the original proposed building with a new, smaller building. They also copied and amended the surveyor's two-dimensional copyrighted site plan, including the footprint of the smaller building. This suit resulted.

In this case the law should have provided the surveyor with enforceable rights as to the entire site plan. To a large degree, by the misguided opinions of the District Court and the Second Circuit Court of Appeals, it was held that the display of "facts" in the maps and technical drawings are no longer the subject of the copyright law. Hence, they may be copied in two-dimensions or three-dimensions.

The United States Constitution provides that: "The Congress shall have the Power . . . To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries." (Article I, § 8, Cl. 8). Exercising its powers under the Constitution, the Congress, from the earliest days of the nation, provided copyright to the owners/authors of maps. The Copyright Act of 1790 specified three protectable items: maps, charts, and books. Act of May 31, 1790, 1 Stat. 124. In the present day, the Congress has enacted the Copyright Act to provide copyright in all types of works, including

maps, charts, diagrams and other technical drawings. 17 U.S.C. § 101. Amongst other provisions, the Copyright Act also provides that the owner of a copyright "has the *exclusive* rights to do and to authorize any of the following: (1) to reproduce the copyrighted work in copies . . . ; [and] (2) to prepare derivative works based upon the copyrighted work." 17 U.S.C. §§ 106(1) and (2) (emphasis added).

However, in the opinion of the Second Circuit and the District Court almost any expression of a "fact" cannot be the subject of a copyright. This opinion is dramatically in conflict with the law as expressed by four other circuits. The Second Circuit and District Court also believe that, unlike other copyright owners, the owner of a copyright in a map or other technical drawing has no right to prevent anyone from making a three-dimensional version of the work. The Second Circuit and District Court even went so far as to ignore undisputed evidence of perjury which was used by the infringers to hide their direct infringement. Thus, the Second Circuit's ruling in *Sparaco v. Lawler, Matusky, Skelly, Engineers, LLP*, 303 F.2d 460 (2002) has dramatically changed the law as it applies to those who create surveys, maps, plats, and the like and as it stands in five other circuits.

B. What a Site Plan Includes:

A site plan is, as indicated, an extensive and detailed multiplicity of technical drawings and maps. A site plan includes a boundary survey, topographical survey, planimetric plan, site grading, planting and lighting plan, sediment and erosion control, and information required by municipal authorities.

1. <u>Boundary Survey</u>

A site plan starts out with a boundary survey called a "plat" or plan of survey. Historically, the term "plat" is a plot or plotting of a survey which reflects the outside boundaries of a piece of land. In preparation of the "plat" portion of the site plan, the surveyor reviews the deeds for the subject premises as

well as those for the abutting premises, noting any distinguishing features of the land. The boundary lines are then utilized for the preparation of the site plan. In this case, the boundary lines were originally prepared by Petitioner Sparaco, no prior boundary survey existed for the Heritage House site.

2. Topographical Survey

The second element of a site plan is the topographical survey. To prepare the topographical survey, a surveyor takes measurements of the earth and then expresses his/her depiction of the terrain's appearance in the form of contour lines drawn in graphing form. In addition to the contour lines, all physical features on the property must be illustrated on the topographical survey as well. This includes the location, elevation, size, and depth of utilities, drains, sewers, and so forth. The original topographical survey work of the plot was prepared by Petitioner and serves as the basis for the site plan drawings. Petitioner, and those he engaged, prepared all of the above.

3. Planimetric Plan

The next step is the drawing of a planimetric plan, expressing the design for the proposed improvements on the site. The planimetric layout, and the location of all the physical improvements to the property, is the product of the creativity of the person who prepares the plan. Again, Petitioner and those he engaged prepared the original planimetric layout.

4. Site Grading Plan

A site grading plan, indicating the proposed grading of the land, proposed utility services, and the like, is the next item to be incorporated into the site plan.

5. Planting and Lighting Plan

A planting and lighting plan is then designed and laid out. Landscaping and lighting effectuate the beautification of the project. This portion of the plan is a drawing which depicts what the landscape design and lighting design will look like when the site is finally developed and constructed.

6. Sediment and Erosion Control

Sediment and erosion control measures and construction details and additional information will also be shown on a site plan. This, too, was original with Petitioner and those who worked with him.

7. Town Requirements

After the basic boundary survey and topography have been completed and drawn, notes, a vicinity block, bulk table and other requirements of the Town are added to the site plan drawings.

C. Petitioner's Creation of the Infringed Work – A Site Plan:

As indicated, the Petitioner Sparaco is a land surveyor. He and Albert Schunkewitz & Partners, an architectural firm (a non-party to this action) were hired by Respondent developers Northern Metropolitan and Klein to prepare a Site Plan for the development and building of a large senior residence facility called "Heritage House" to be located in the Town of Ramapo, New York. In 1993, Sparaco entered into a written contract (A- 52-56[1]) with Schunkewitz, Northern Metropolitan, and Klein for Sparaco to provide his services. The contract provided that the parties acknowledge that Sparaco is the author of the Site Plan and owns the copyright in the Site Plan.

Over a period of years (beginning on a date at least four years before the 1993 contract was entered), Sparaco (with his employees and his subcontractors) prepared an extensively detailed 14-page Site Plan which consisted of all of the design elements needed to construct the Heritage House site.

This Site Plan was submitted to the Town of Ramapo for approval to develop and construct the site. It was approved by the Town of Ramapo for building (hereinafter the "Approved Site Plan"). (See site plan at A-438, Exhibit G.)

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1. A- refers to the Joint Appendix in the Second Circuit.

Upon the approval of the Town of Ramapo, Sparaco filed and was granted a copyright registration for the 14-page Site Plan. (A-41.)

Shortly after the Town's approval of the Approved Site Plan, the Respondent developers Northern Metropolitan and Klein decided to decrease the size of the proposed buildings thereby reducing the cost of construction. These Respondents hired Respondent architect Dahn & Krieger to design a new, smaller building footprint and shell to be, in accordance with their written contract: "in general conformance with the '*Approved Site Plan Drawings 1-14* by A.R. Sparaco, Jr., last revised July 25, 1995.'" (A- 287)

The new architect, Respondent Dahn & Krieger, thereupon designed the new, smaller building for the property using the Approved Site Plan to redesign the shape of the building. There is no doubt of the infringement. The contract (A-287) between Respondent developer Northern Metropolitan and Respondent architect Dahn & Krieger required the architect to engraft their new building footprint and shell into the parameters of Petitioner Sparaco's original building footprint on the Approved Site Plan.

Dahn & Krieger copied the Approved Site Plan in a drawing and incorporated the new building footprint. Dahn & Krieger's rendering is substantially similar in that they copied the landscape design, the parking lot and curb designs from Petitioner Sparaco's Approved Site Plan. Drawing. (A-318) Once Respondent Dahn & Krieger had designed the new building, it became necessary to amend the Approved Site Plan to accommodate the redesigned building footprint.

In breach of the 1993 contract (A- 52-56) with Sparaco, Respondents Northern Metropolitan and Klein did not hire Sparaco to amend the Approved Site Plan. Instead, Respondents Northern Metropolitan and Klein directed their agent, contractor/ builder Respondent Graham & Alexander, to hire Respondents Lawler Matusky and Vanderbeek, to amend the Approved Site

Plan for less money than charged by Sparaco. Lawler Matusky and Vanderbeek were hired to copy, by digitizing, the Approved Site Plan, and to insert architect Dahn & Krieger's new building footprint into the copy. Respondents' amended site plan copied a significant portion of Sparaco's Approved Site Plan including the boundary survey, the topographical survey, the original building footprint, parking lot designs, curb placement and lighting design. Respondents Lawler Matusky and Vanderbeek then modified the Approved Site Plain by amending the proposed grading and utility placement that appeared on the Approved Site Plan. The modifications were made to accommodate the new building.

Respondent contractor/builder Graham & Alexander then prepared the land for development and construction using the digitized copy of the amended Approved Site Plan.

An inspector from the Town of Ramapo, on a routine inspection of the site, discovered that Respondent contractor/ builder Graham & Alexander was building the site in accordance with a modified copy of the Approved Site Plan. The Town immediately issued a Stop Work Order and ordered that a new site plan be submitted immediately showing the changes that had been made to Appellant Sparaco's Approved Site Plan.

In response to the Stop Work Order, Respondent engineers Lawler Matusky and Vanderbeek took the digitized copy of the Approved Site Plan, incorporated a few minor amendments (i.e., "field changes") and filed the new site plan with the Town of Ramapo.

Once the Stop Work Order was lifted, construction on the site was resumed by Respondent contractor/builder Graham & Alexander. The site was then developed in accordance with the amended infringing site plan which was derived from Sparaco's Approved Site Plan with the incorporation of a few minor changes. In the end, the Appellees developed and built a 10 acre senior residence facility directly from and in accordance with the Approved Site Plan.

With the exception of the changes in the building itself, the final constructed site is an infringement of the site as depicted in the Approved Site Plan.

D. Proceedings in the Courts Below – the District Court:

The complaint in this action sets forth that Respondents infringed upon Petitioner Sparaco's copyright in his 14-page Approved Site Plan. It further claims Respondent developers breached the contract with Sparaco. Finally, it claims that Respondents infringed upon Petitioner's trademark rights under the Lanham Act by using Petitioner's name on the filed infringing site plan.

Petitioner moved for a preliminary injunction. Respondents moved to dismiss the action as against them. After a hearing before, and recommendations by, a Magistrate-Judge, the District Judge granted Respondents' motion dismissing the Lanham Act claim. The District Court denied the Respondent developers' and engineers' motion to dismiss the copyright infringement claims. The Court granted the motion by Respondents architect and engineers to be dismissed, holding that including these parties in the action was "objectively unreasonable." The District Court, *sua sponte*, granted Sparaco summary judgment on the breach of contract claim, holding that the Respondent developers had breached their contract with Sparaco by hiring another party to copy his Approved Site Plan. *Sparaco v. Lawler*, 60 F. Supp. 2d 247 (S.D.N.Y. 1999).

This Court's decision in *Feist v. Rural Tel. Serv. Co., Inc.*, 499 U.S. 340, 113 L. Ed. 2d 358, 111 S. Ct. 1282 (1991) forms the underpinnings of the rulings by the District Court and the Second Circuit. In *Feist*, this Court held that when existing facts are merely physically rearranged, as, for example, lists in a telephone directory, there is no copyrightable subject matter. This is because the resulting work is merely the result of a "sweat of the brow" rearrangement. *Feist, supra*, 499 U.S. at 361. In its decision, the District Court recognized that this Court

also held in *Feist* that, all that is required to obtain a copyright is a "minimal degree of creativity." *Sparaco*, 60 F. Supp. 2d at 251.

This Court's plain language in *Feist* of the minimum amount to support a copyright was then ignored by the District Court. It held that, where Petitioner portrays existing physical features of the property, such representations are not copyrightable because these are "facts." *Sparaco*, *supra*, 60 F. Supp. 2d at 252. In *Feist*, as indicated, the facts were in existence and all the creator did was rearrange them. In its misguided reading of *Feist*, the District Court concluded that, if the origin of Sparaco's work reflected facts in another form, those facts are nevertheless in existence and no expression of the facts is copyrightable. The District Court also held that some nonexistent features (i.e., the depiction of the new improvements to the property) are copyrightable (e.g., the footprint of the building and alterations resulting from the footprint).

Here, however, the unrebutted evidence shows that the work did not present a listing of facts rearranged on a piece of paper. Rather, Petitioner, and those who assisted him, made original measurements. They then, in a second creative step, chose which measurements to use. In a third creative step, Petitioner decided how the mathematical determinations could best be translated into lines and cartographic symbols. In a fourth creative step, Petitioner Sparaco then decided how to present those selected measurements in two-dimensions on paper to represent three dimensional actual and proposed features of the project. What Petitioner put on paper were graphical representations in two dimensions of the existing features (e.g., contours) and nonexistent features (e.g., boundary lines).

The dismissal of the Respondent architect Dahn & Krieger and the Respondent contractor/builder Graham & Alexander was based upon a misinterpretation of the Copyright Act. The District Court dismissed the architect and contractor/builder from the suit, holding that the new building footprint and the

three-dimensional site construction, including curbs, driveways, and landscaping, could not possibly infringe Petitioner's work because these are three-dimensional constructions of Sparaco's two-dimensional Approved Site Plan (*Sparaco*, *supra*, 60 F. Supp. 2d at 251). In its decision, in which it dismissed the Respondent architect and the Respondent builder/contractor, the District Court held:

> As long as the new architect and the builder who carried out the architect's vision did not make copies of Plaintiff's copyrighted work (i.e., his site plan), they did not violate his copy-right.
>
> As the Magistrate Judge correctly found, there is no evidence in this record that either D&K or G&A either copied or caused anyone else to copy plaintiff's work.

Sparaco, *supra*, 60 F. Supp. 2d at 251. The District Court entered judgment awarding them attorneys' fees. Without any support in the Copyright Act (in fact, contrary to the Copyright Act) and case law, the District Court held that "Plaintiff's only right (if he had any right) was a **copy**-right – that is a right to keep others from making copies of his original work." (emphasis in original.) *Sparaco*, 60 F. Supp. 2d at 251.

Thus, the District Court, deprived Petitioner (and all other surveyors and creators of two dimensional works) of his right to enforce his copyright against an infringer that makes a three-dimensional derivative version of his work and/or incorporates his work – a right guaranteed to him under the Copyright Act. 17 U.S.C. §§ 101 and 106(1) and (2).[2]

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2. 17 U.S.C. § 101 provides: "A 'derivative work' is a work based upon one or more preexisting works . . . or any other form in which a work may be recast, transformed, or adapted."

17 U.S.C. §§ 106(1) and (2) grants exclusive rights to copyright owners "(1) to reproduce the copyrighted work in copies. . . . ; (2) to prepare derivative works based upon the copyrighted work."

After the dismissal of the contractor/builder and architect, Petitioner Sparaco discovered evidence that, contrary to the contractor/builder's and architect's sworn statements, these parties had ***directly*** infringed Sparaco's work. In refusing to consider the Petitioner's motion to vacate, the District Court failed to review and consider this unrebutted evidence and that the Respondents had, in fact, committed perjury to secure their dismissal.

The evidence obtained against Dahn & Krieger was:

(1) An infringing copy of the Approved Site Plan (copying landscaping, parking lots, curbs, etc.) drawn by Dahn & Krieger. Drawing (A-318);

(2) Testimony that the infringement was "a joint effort between Dahn & Krieger and Graham &Alexander and [Lawler Matusky] . . ." (A-305. excerpt of the sworn testimony of Respondent Vanderbeek at 35, lines 17-20);

(3) Respondent Dahn & Krieger's notes which specifically refer to a direction to copy Petitioner's site plan (A-299-A-301 and A-314-A-315);

(4) Testimony by Respondent Vanderbeek that Dahn & Krieger participated in the infringement. (A-308-A-309 and A-12-A-313); and

(5) Respondent Dahn & Krieger's contract with Respondent developer Northern Metropolitan proving that Dahn & Krieger was hired to design a new building *using Sparaco's site plan*, thereby creating a derivative work from the Approved Site Plan. (A-287-A-298).

The evidence obtained against Graham & Alexander is:

(1) a letter in which Respondent Graham & Alexander ***hired*** Respondent Lawler Matusky to infringe Petitioner's work

> Upon receipt of a clean copy of the original [i.e., Petitioner's] grading plan, we would digitize the existing conditions into an AutoCad format.

> Then, based on your Architect's new layout (which Mr. Bill Dahn has given us in a CADD format), we would prepare a draft grading plan. . . . We are not proposing to execute a new analysis of the drainage facilities at this time. (A-273-A-274);

(2) Respondent Vanderbeek's testimony that

a) Respondent architect Graham & Alexander hired Respondent engineer Lawler Matusky to infringe Sparaco's site plan;

b) Respondent Graham & Alexander oversaw the infringement;

c) Respondent Lawler Matusky worked jointly with Respondents Graham & Alexander and Dahn & Krieger on the infringing copies;

d) Respondent Graham & Alexander participated in the infringement. (Vanderbeek testimony at A-302-A-317 and A-442)

Thus, Respondents Dahn & Krieger and Graham & Alexander directly infringed Sparaco's copyrighted work. They were integrally involved in the infringement from the hiring of infringer Respondents Lawler Matusky and Vanderbeek, to the creation of the infringing work.

However, in support of their motion to be dismissed, Respondent architect Dahn & Krieger made these false representations to convince the District Court that they were not direct infringers:

- "Dahn & Krieger, however, in no way undertook any responsibilities in connection with the site plan for the new design. (referring to the redesign of the building)." (A-58, ¶5)

- "Dahn & Krieger did not undertake any duties in connection with the site plan for the new design." (A-112, ¶6)

Respondent builder/contractor Graham &Alexander, in support of their motion to be dismissed also made knowing false representations:

- "Castle American [another name for Respondent Graham & Alexander] had no role whatsoever in creating or altering the site plans which give rise to this lawsuit." (A-62, ¶3)

- "Castle American did not contract with Mr. Sparaco and had no prior access to these plans, nor did it have any input into the making of these plans." (*Id.* ¶4.)

Later, Respondent developers and engineers moved to dismiss Petitioner's action for lack of subject matter jurisdiction. The Petitioner cross-moved, pursuant to Fed. R. Civ. P. 60(b)(3), to vacate the judgment dismissing the contractor/builder and architect in view of the newly discovered evidence.

The District Court directed the architect and the contractor/ builder not to respond to the Petitioner's motion to vacate. The District Court directed a hearing on the issue of subject matter jurisdiction. At that hearing, held August 10, 2000 (L-3 - L-73), the District Court denied Respondent developers' and engineers' motion to dismiss for lack of subject matter jurisdiction.

The District Court, *sua sponte*, dismissed Petitioner's copyright infringement claims, holding that under the Second Circuit's holding in *Attia v. The Society of the New York Hospital*, 201 F.3d 50 (2d Cir. 1999), *cert. den.*, 531 U.S. 843, 148 L. Ed. 2d 67, 121 S. Ct. 109 (2000), "nothing" in the Approved Site Plan "qualifies for copyright protection." *Sparaco v. Lawler, Matusky, Skelly Engineers LLP*, 2000 U.S. Dist. LEXIS 22177 *36 (S.D.N.Y. August 31, 2001).

The District Court refused to consider Petitioner's cross-motion, completely ignoring the evidence of perjury, all because the District Court reached the erroneous decision that Petitioner has no copyright under *Attia. Id.*

E. Proceedings in the Courts Below – the Second Circuit:

Petitioner appealed to the Second Circuit Court of Appeals. The Respondent developers and engineers cross-appealed. The Second Circuit denied the cross-appeal and reversed and remanded to the District Court the dismissal of the Petitioner's action for copyright infringement. The Second Circuit held that the District Court had erred in its interpretation of the Second Circuit's decision in *Attia, supra.* Specifically, the Second Circuit agreed with Petitioner that his Approved Site Plan was sufficiently detailed to sustain a valid copyright under the Copyright Act. *Sparaco v. Lawler, Matusky, Skelly Engineers LLP*, 303 F.3d 461, 468-469 (2002).

1. ***The Second Circuit Denies Copyright in Survey Maps***

Most importantly, the Second Circuit decided that survey maps are not copyrightable. This is the very heart of Petitioner's and other surveyor's creative work. The Second Circuit held

> To the extent that the site plan sets forth the existing physical characteristics of the site, including its shape and dimensions, the grade contours, and the location of existing elements, it sets forth facts; copyright does not bar the copying of such facts. . . . [A] mapmaker is not protected form copying of the factual information conveyed in a map. . . .

Sparaco, supra, 303 F.3d at 467. According to the Second Circuit, the *only* aspects of the map which are protectable are the specific appearance – that is "the selection or elimination of detail, the size, shape, and density *of informative legends*, the *establishment of conventions* relating to color or design to represent topographical or other features, and many other features of presentation." (*Id.*) (emphasis added) The entire rationale for the Second Circuit's ruling is the result of its misinterpreting this Court's ruling in *Feist.* This Court held that the mere physical rearrangement of existing facts is not copyrightable. The Second Circuit erroneously construed this

to mean that where facts (i.e., measurements) are then transformed into an expression in a map, the expression cannot be the subject of copyright. Indeed, according to the Second Circuit, he expression is in the public domain and, apparently, even this may apply to proposed changes to a plan (i.e., nonexistent facts).

The unrebutted evidence established that the survey in the site plan was entirely original and not comprised of the type of facts set forth in *Feist*:

• Petitioner's affirmation that he independently created the site plan using his creativity and artistic ability (i.e., he did not copy the work from another source.) (A-142 at ¶21 and ¶22)

• Petitioner's unrebutted sworn affirmations which set forth that:

(1) A plat (or boundary survey) "reflects the related 'original' work of the design professional which would . . . qualify for copyright protection." (A-138 at ¶5);

(2) "A survey reflects a professional *opinion*, based on substantial effort, judgment, discretion, experience, knowledge, information, and belief" (A-138 at ¶7);

(3) "The survey and preparation of a site plan requires the science and art of determining area and configuration of portions of the surface of the earth, and representing them on maps" (A-139 at ¶9);

(4) "The land surveyor expresses his/her representation of what the surface of the earth looks like in the form of contour lines. . . . The originality of the survey work is the basis for the site plan drawings." (A-139 at ¶10);

(5) The representation of physical features on the map (i.e., existing contours) is the land surveyor's original interpretation of how these features should be presented in graphing form. (A-140 at ¶14);

(6) A surveyor's map shows one expression, opinion, or artistic interpretation of how a physical feature of the earth will be represented on a map. (A-141 at ¶19).

• The unrebutted sworn affirmation of Town of Ramapo Director of Public Works, Edward Dzurinko, that "Land surveying is more than the following of coordinates and direction. It is the interpretation of data that is discovered or investigated by the surveyor. In 19 years, I have never seen two exact surveys prepared by different surveyors of the same property." (A-328 - A-329 at ¶17)

Although the Circuit Court alleges that Respondents provided evidence of unoriginality, the only "evidence" was their argument that Petitioner used standard lines (i.e., dotted and solid) and cartographic symbols to depict contour lines and water lines. This, of course, misses the point. It is not the existence of lines and symbols, but their unique (to that work) placement which is original.

As a direct consequence of this ruling, the Second Circuit has created a rule of law that deprives all authors of their rights in any technical or scientific drawing.

(The Second Circuit's footnote that Petitioner has no remaining copyright damages because of the settlement of the contract claim is also in error. The settlement (L-1 - L-2) was as to the Respondent developers only and expressly permits Petitioner Sparaco to seek recovery for copyright infringement. There is no settlement with respect to the infringing engineers.)

2. *The Second Circuit Denies Petitioner's Rights in Derivative Three-dimensional Works and Affirms the District Court's Dismissal of the Architect and Contractor/Builder*

At the end of a footnote, the Second Circuit, in an aside, affirmed the District Court's denial of Petitioner's motion to vacate the judgment against Respondents Dahn & Krieger and Graham & Alexander and subsequently awarded

attorneys' fees on the appeal. *Sparaco*, *supra*, 303 F.3d at 469 (footnote 2).

Like the District Court, the Second Circuit, without discussion, affirmed the District Court's decision that Sparaco could have no copyright in any three-dimensional infringing work made by the Respondent architect and contractor/builder. Like the District Court, it failed to consider the evidence of direct infringement by Respondents and the false testimony they provided to hide the facts from the District Court. It also failed to recognize that the constructed three-dimensional work infringed Petitioner's copyrighted Approved Site Plan, a two-dimensional work.

REASONS FOR GRANTING THE PETITION

I. The Decision Below on Copyrightability of Maps Presents Important Conflict Among the Courts of Appeal

The Second Circuit ruling that any "fact" presented in a map or other technical drawing is per se not copyrightable, even if the fact is a measurement independently created, selected, and transformed into a visual depiction on a map, conflicts with the law as set forth in the Third, Fifth, Seventh, Eighth, and Ninth Circuits.

(1) The Fifth Circuit:

The copyrightability of the Approved Site Plan is made no more clear than in *Mason v. Montgomery Data Co.*, 967 F.2d 135, 140 (5th Cir. 1992). The Fifth Circuit holds that under this Court's holding in *Feist,* maps are copyrightable subject matter. The selection, coordination, and arrangement of information in Mason's maps was sufficient to qualify them as original 'compilations of facts.' Such compilations of facts are copyrightable when the author decides the facts to be included, the order of inclusion, and the arrangement of collected data. *Mason*, *supra*, 967 F.2d at 141. In *Mason*, the court held that Mason's real estate ownership maps were original and pass

muster under the Copyright Act. Petitioner Sparaco did more than extract the expression of the map from those of others. He *created* the expression in a wholly original survey. The so-called "facts" do not appear directly on the land. They are transformed into lines and cartographic symbols and he arranged them artistically and they appear nowhere else.

(2) The Seventh Circuit:

In *Rockford Map Publishers, Inc. v. Directory Service Company of Colorado, Inc.*, 768 F.2d 145 (7th Cir. 1985), *cert. den.*, 474 U.S. 1061 (1986), Directory Service copied Rockford's plat maps (i.e., boundary surveys). Rockford created its plat maps by tracing existing features from photographs and deriving boundary lines from recorded deeds. The Circuit Court held that Rockford had a valid and enforceable copyright in its plat maps. Directory argued that Rockford could not copyright the statistical information found on file in county deeds, since these were facts. To this, the Seventh Circuit held:

> The copyright laws are designed to give people incentives to produce new works. See *Harper & Row, Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539, 105 S. Ct. 2218, 2223-24, 85 L. Ed. 2d 588 (1985); *Sony Corp. v. Universal City Studios, Inc.*, 464 U.S. 417, 104 S. Ct. 774, 782, 807, 78 L. Ed. 2d 574 (1984). They allow people to collect the reward for their contributions. If the incremental contribution is small, so too is the reward, but a subjective assessment of the importance of the contribution has nothing to do with the existence of copyright. 768 F.2d at 148.

As to Directory's argument that Rockford expended little effort in the creation of the infringed work, the Circuit Court held:

> Here Rockford Map made a contribution. Its employees dug through the records and turned

> the metes and bounds of the legal descriptions into ***a pictorial presentation***. Teasing pictures from the debris left by conveyancers is a substantial change in the form of the information. The result is copyrightable, no matter how quickly Rockford Map's staff could do the work. *See* Robert A. Gorman, *Copyright Protection for the Collection and Representation of Facts*, 76 Harv. L. Rev. 1569, 1573-76 (1963). 768 F.2d at 149. (Emphasis added.)

In the present case, Sparaco did not use compilations of existing lines, let alone a prior map or photograph. The work was entirely original to Sparaco. He and his agents actually made the very measurements and then selected and transformed those measurements into lines and cartographic symbols to create the survey the Respondents copied. Under the Second Circuit's ruling neither he, nor Rockford, have any copyright in the map or survey.

The Second Circuit takes the position that the result of this Court's decision in *Feist* is that factual arrangements of data in the form of a map are no longer copyrightable, notwithstanding that maps are specifically enumerated among the works protected in the earliest copyright statutes. This position is in direct conflict with the Seventh Circuit where, in *American Dental Association v. Delta Dental Plans Association*, 126 F.3d 977, 978-979 (7th Cir. 1997), the Circuit Court held:

> Maps and globes are not only copyrightable, see *Rockford Map Publishers, Inc. v. Directory Service Co.*, 768 F.2d 145 (7th Cir. 1985), but also constituted two-thirds of the original scope of copyright. The Copyright Act of 1790 specified three protectable items: maps, charts, and books. Act of May 31, 1790, 1 Stat. 124. Like taxonomies, maps are valued to the extent they offer useful organizations of facts; like the Code, maps are produced by committees. (As are opinions of

> appellate courts, which despite this handicap, and the judges' effort to produce something useful, might occasionally have a modicum of originality.)

The Seventh Circuit decisions do not bar anyone from acquiring factual information – in this case the measurements of a site – and making their own map. What it bars is the copying of the very map created by the author, even where the map is a compilation of existing data. The Second Circuit takes the opposite position: that if a document contains facts, all of the facts may be copied in just the manner they are expressed by the author.

(3) The Eighth Circuit:

Rockford is cited with approval by the Eighth Circuit in *West Publishing Co. v. Mead Data Central, Inc.*, 799 F.2d 1219, 1223 (8th Cir. 1986), *cert. den.*, 479 U.S. 1070, 93 L. Ed. 2d 1010, 107 S. Ct. 962 (1987) to support their holding that any contribution, no matter how slight, is protectable. Here, there is no question that Respondents copied and then made changes to Petitioner's Approved Site Plan. Thus, the Eighth Circuit would have reached an entirely different result in this case than did the Second Circuit.

(4) The Third Circuit:

The Third Circuit in *Andrien v. Southern Ocean County Chamber of Commerce*, 927 F.2d 132, 134 (3d Cir. 1991) adopts the reasoning of the Seventh Circuit in *Rockford* and is, therefore, in direct conflict with the Second Circuit. The reliance by the Third Circuit on its earlier decisions may mean that the Third Circuit holds that there is no copyright for that portion of a map which is copied from another map or similar source. This does not change the result in this case, since Sparaco did not copy from any other source including public or third party sources.

(5) The Ninth Circuit:

The Ninth Circuit in *United States v. Hamilton*, 583 F.2d 488, 450-451 (9th Cir. 1978), is directly in conflict with the

Second Circuit. *Hamilton* is a criminal case in which Hamilton copied a copyrighted map. The Ninth Circuit held that a map has sufficient originality to be the subject of a copyright where the selection, arrangement, and presentation of terrain features which were already either in the public domain or subject to separate copyright may be considered as part of the efforts and skill which constitute a cartographer's authorship.

The Ninth Circuit thus entirely rejects the law as determined by the Second Circuit. The Ninth Circuit would, along with the Third, Fifth, Seventh, and Eighth Circuits, find Petitioner's work fully copyrightable and would also enforce the copyright where the actual drawing of the contours and boundary, for example, were assembled from other sources and arranged by the author. Where the Third Circuit parts form the Ninth Circuit is that in the Third Circuit, maps prepared from public domain information alone are not the subject of copyright. Now, in the Second Circuit, no map or technical drawing can be the subject of a copyright.

II. The Supreme Court Has Not Definitively Ruled on What Parts of a Map or Survey are Copyrightable

To date the Supreme Court has ruled that maps, in general, are copyrightable, but not as to what, in view of *Feist*, are the specific copyrightable elements. The most nearly analogous holdings can be found in *Burrow-Giles Lithographic Company v. Sarony*, 111 U.S. 53, 56, 4 S. Ct. 279, 28 L. Ed. 349, 1884 U.S. LEXIS 1757 (1884), that a photograph, although a "reproduction on paper of the exact features of some natural object or of some person, is not a writing of which the producer is the author," is nonetheless copyrightable. Pursuant to the reasoning in *Burrow-Giles*, if a photograph of a natural object is entitled to protection, then certainly, a reproduction of what a plat of land looks like on paper is equally eligible of such protection.

In holding appellant's lithographs copyrightable, the Supreme Court held in *Bleistein v. Donaldson Lithographing Company*, 188 U.S. 239, 249, 23 S. Ct. 298, 47 L. Ed. 460, (1903):

> But *even if they had been drawn from the life, that fact would not deprive them of protection.* The opposite proposition would mean that a portrait by Velasquez or Whistler was common property because others might try their hand on the same face. Others are free to copy the original. They are not free to copy the copy. *Citing Blunt v. Patten*, 2 Paine, 397, 400. (emphasis added.)

The conflicts in the Circuits will, and has happened already in this case, result in different law in different parts of the nation as to surveyors and, undoubtedly, by extension, the authors of any other fact-based drawing. Thus, a surveyor residing in New Jersey, for example, has entirely different rights if he performs his services in Newark as compared to those services he renders after he crosses the George Washington Bridge.

III. The Second Circuit Holds That a Three-Dimensional Work Cannot Infringe a Two-Dimensional Work

In this case, the Respondent architect used a copyrighted Site Plan to design a building which was specifically dimensioned to fit within and conform to the parameters set forth in that Site Plan. The contractor/builder then made an unauthorized three-dimensional copy of Petitioner's Approved Site Plan, including the landscape, curbs, drives, and footprint (as they were modified by Respondents), as well as the building that was designed and built using and based upon the site plan.

The Second Circuit affirmed the District Court's holding that "the only right that Petitioner had was a **copy**-right – that is a right to keep others from making copies of his original work." (emphasis in original) *Sparaco*, 60 F. Supp. 2d at 251, by affirming their dismissal from the action. The Second Circuit

also affirmed the District Court's holding that Petitioner was "objectively unreasonable" in having brought the suit against these parties. This was done by the District Court in a motion for summary judgment where, as a matter of law "the inferences to be drawn from the underlying facts contained in such materials must be viewed in the light most favorable to the party opposing the motion." *United States v. Diebold Inc.*, 369 U.S. 654, 655, 8 L. Ed. 2d 176, 82 S. Ct. 993 (1962). Here, all inferences were drawn against Petitioner.

By affirming the District Court, the Second Circuit has amended the Copyright Act carving out an exception to the statute. The Copyright Act, 17 U.S.C. § 101, provides that "[a] "derivative work" is a work based upon one or more preexisting works . . . or any other form in which a work may be recast, transformed, or adapted." 17 U.S.C. § 106 provides exclusive rights to the copyright owner "(1) to reproduce the copyrighted work in copies or phonocopies; (2) to prepare derivative works based upon the copyrighted work; . . ."

It had been longstanding law in the Second Circuit that the unauthorized creation of a three-dimensional work from a two-dimensional work is copyright infringement. *See, e.g., King Features Syndicate v. Fleischer*, 299 F. 533 (2d Cir. 1924) (a doll copied from the cartoon character "Barney Google"); *Hill v. Whalen & Martell, Inc.*, 220 F. 359 (2d Cir. 1914) (dolls copying the cartoon characters "Mutt & Jeff"). This is the law in other circuits as well. In the Ninth Circuit, for example, there is *Micro Star v. Formgen Inc.*, 154 F.3d 1107 (9th Cir. 1998).

Under the Second Circuit/District Court's unexplained ruling, a derivative and unauthorized three dimensional copy of a two dimensional work is not copyright infringement if the work is based upon a site plan, map, plat, or the like. It is respectfully submitted that the Second Circuit and the District Court are in error and should be reversed.

IV. The Second Circuit Erred by Affirming the Denial of Petitioner's Motion to Vacate the Judgment to Dismiss the Architect and Contractor/Builder

A District Court may relieve a party from a final judgment, order, or proceeding for "fraud (whether heretofore denominated intrinsic or extrinsic), misrepresentation, or other misconduct of an adverse party." Fed. R. Civ. P. 60(b)(3). This Court held in *United States v. Beggerly*, 524 U.S. 38, 48 (1998) that:

> Independent actions must, if Rule 60(b) is to be interpreted as a coherent whole, be reserved for those cases of "injustices which, in certain instances, are deemed sufficiently gross to demand a departure" from rigid adherence to the doctrine of *res judicata*. *Hazel-Atlas Glass Co. v. Hartford-Empire Co.*, 322 U.S. 238, 244, 88 L. Ed. 1250, 64 S. Ct. 997 (1944).

Here, the unrebutted evidence against Respondents Dahn & Krieger and Graham & Alexander show that they had, in fact, infringed Petitioner Sparaco's copyrighted Approved Site Plan and then committed perjury to convince the District Court that they were not infringers. As testified to by Respondent Vanderbeek, the infringement by copying of the Approved Site Plan was "a joint effort between Dahn & Krieger and Graham &Alexander and [Lawler Matusky] . . ." and the contract between Respondent Graham & Alexander and Respondent Northern Metropolitan *required them to copy and infringe the Approved Site Plan*. There is even a letter in which Graham & Alexander hired Lawler Matusky to infringe Sparaco's work. In the face of overwhelming evidence, the District Court erred by declining to even read Petitioner's motion under Rule 60(*b*) let alone consider the later-found evidence. (L-73, lines 9-19.)

The Second Circuit and District Court finding should be reversed and the judgment dismissing the Respondent contractor/builder Dahn & Krieger and the Respondent architect Graham & Alexander vacated.

CONCLUSION

It is apparent that the District Court and the Second Circuit are uncomfortable with the concept that a surveyor or other creator of a site plan, survey, map, plat or the like is entitled to the same rights under the Copyright Act as the author of any other work. All of their decisions were made in response to summary judgment motions, without a full development of the case.

The Second Circuit's ruling that anyone is free to copy a map, so long as the copier merely changes the "selection or elimination of detail, the size, shape, and density of *informative legends*, the *establishment of conventions* relating to color or design to represent topographical or other features, and . . . other details of presentation" (emphasis added) is clearly contrary to law, ill-founded, and in conflict with five other circuit courts of appeal. So, too, is its affirmance of the holding that the copyright in a survey does not extend to three dimensional versions of the site. On the other hand, one cannot discount the challenge that the Second Circuit and other courts face in light of the lack of guidance regarding the distinction between the use of facts as they appear in a telephone directory, as opposed to those that appear in maps or other technical drawings. Also, the courts face the daunting task of determining when and under what conditions a three-dimensional rendition of a two-dimensional site plan constitutes an infringement.

Only this Court can authoritatively face and resolve, once and for all, the quandary created by the application of the law as set out by this Court in *Feist*.

Respectfully submitted,

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APPENDIX

APPENDIX A — OPINION OF THE UNITED STATES COURT OF APPEALS FOR THE SECOND CIRCUIT DATED JUNE 26, 2002 AND FILED AUGUST 29, 2002

UNITED STATES COURT OF APPEALS
FOR THE SECOND CIRCUIT

Docket No. 99-9519 (L), 01-9199 (CON), 01-9289 (XAP)

June 26, 2002, Argued

August 29, 2002, Decided

ALBERT SPARACO, JR.,

Plaintiff-Appellant-Cross-Appellee,

v.

LAWLER, MATUSKY, SKELLY, ENGINEERS LLP, THOMAS B. VANDERBEEK, NORTHERN METROPOLITAN FOUNDATION and MORRIS KLEIN,

Defendants-Appellees-Cross-Appellants,

DAHN & KRIEGER ARCHITECTS PLANNERS PC and GRAHAM & ALEXANDER,

Defendants-Appellees.

OPINION

Appendix A

Before JACOBS, LEVAL, and KATZMANN, Circuit Judges.

LEVAL, *Circuit Judge*:

Plaintiff Albert R. Sparaco, Jr. ("Sparaco"), a land surveyor and planner, appeals from a judgment of the United States District Court for the Southern District of New York (Colleen McMahon, *J.*) granting summary judgment to defendants and dismissing his claim of copyright infringement. Plaintiff's complaint alleged that various entities and individuals involved in the development of an assisted living facility unlawfully copied his site plan in creating an amended site plan for use in the construction of the facility. We vacate the grant of summary judgment and remand for further proceedings.

BACKGROUND

A. Underlying Events

In 1989, defendants Northern Metropolitan Foundation for Health Care, Inc. ("NMF") and Morris Klein ("Klein"), its executive director, undertook to develop an assisted living facility to be known as the "Heritage House" in the town of Ramapo in Rockland County, New York. To develop the design of the facility, NMF hired two architectural firms: Albert Schunkewitz and Partners ("Schunkewitz") and Jerome Meckler Associates ("Meckler"). Schunkewitz and Meckler retained the plaintiff Sparaco to prepare a "site plan" of the development project for submission to the Ramapo planning board.

Appendix A

A site plan is a development plan for a plot of land. It specifies existing land conditions, including topography, boundaries, and physical structures, and can also specify the proposed improvements to the site. The town of Ramapo requires an applicant for a building permit and certificate of occupancy to submit a site plan.

Schunkewitz and Meckler had prepared "conceptual sketch architectural drawings" of the building "footprint"—the shape or outline of the building on the land surface—and surrounding parking areas. They provided these drawings to Sparaco for integration into the site plan. Sparaco in turn hired Robert Torgerson, a landscape architect and independent contractor, to assist in developing the site plan. Sparaco's personal contribution to the creation of the site plan was minimal. He supervised Torgerson in the refinement of Schunkewitz and Meckler's drawings and made several adjustments in response to suggestions from Ramapo authorities.

Financial constraints led NMF to dismiss Meckler, leaving Schunkewitz as the sole architect on the project. In August 1993, Sparaco formalized his involvement in the Heritage House project and executed an agreement with Schunkewitz and NMF. The contract provided, *inter alia,* that the surveyor's drawings and plans would not be used by the client "for the completion of this project by others, except by a separate agreement in writing, and with appropriate compensation to the surveyor."[1] The contract also provided

1. The clause in question provided:

> The survey notes, worksheets, plans, documents and drawings are instrumentalities of the service being provided for use solely for this particular project or

(Cont'd)

that NMF was not to "copy, reproduce, or adapt the drawings" without Sparaco's written consent.

(Cont'd)

> application and shall remain the property of the surveyor [Sparaco]. The client [Schunkewitz and NMF] shall be permitted to retain copies for information and reference in connection with the Client's use of the property surveyed, designed or planned. The drawings shall only be used by the Client for the purpose for which they are prepared, unless the parties agree otherwise in a written and signed instrument and with appropriate compensation to the Surveyor. The parties hereto acknowledge that the surveyor is the author of the drawings and documents and shall retain all common law, statutory and other reserved rights, including the United States Copyright law, *17 U.S.C. § 101* et seq., and thereby retains sole ownership of the copyright in and to the drawings. In recognition of the Surveyor's claim to ownership and copyright, the Client shall not copy, reproduce, or adapt the drawings or engage in any other activity which would violate the copyright therein without the Surveyor's written consent. To do so shall be deemed a material breach of this contract. The surveyor's drawings, plans or other documents shall not be used by the client, owner, or any other party for additions to this project or for the completion of this project by others, except by a separate agreement in writing, and with appropriate compensation to the surveyor. Submission or distribution of maps, documents, etc. to meet official regulatory requirements, or for similar purposes in conjunction with this particular project is not to be construed as publication in derogation of the surveyor's reserved rights.

Appendix A

Sparaco completed the site plan in December 1993 and soon thereafter signed and filed it on behalf of NMF with the Ramapo authorities. Ramapo approved the site plan. The final version of the plan was a 14-page document entitled "Complete Set of Drawings for Site Plan 'Heritage House' Sheets 1 through 14." In accordance with the Ramapo Planning Board's regulations, the site plan incorporated a rendering of: (1) the existing physical characteristics of the site; and (2) the proposed physical improvements to the site.

As to existing features, the site plan included a basic survey map of the parcel of land, using cartographic conventions to portray boundaries, zoning districts, plot lines, abutting parcels, and public streets abutting or crossing the site. It also contained a topographical survey that shows elevations with contour lines, and depicts the location, elevation, size, and slope of existing physical structures such as utility lines, drains, valves, hydrants, and sewers.

As to proposed improvements to the site, the plan contained (1) the location and contour of the building footprint; (2) location and contour of parking lots; (3) placement and design of curbs, driveways, and walkways; (4) placement of utilities and provision for sediment and erosion control; (5) landscape design, including the location for plants, trees, and lights; and (6) proposed changes to the contours and elevation of the terrain.

In December 1996, Sparaco obtained a certificate of copyright for the site plan. He registered the site plan under the category of a "map" and "technical drawing." Sparaco listed only himself as the "author" of the site plan in his application for registration.

Appendix A

Unsatisfied with the building design, NMF removed Schunkewitz from the project and hired defendant Graham & Alexander ("G & A"), a construction management firm, to oversee the continuation of the Heritage House development. NMF also retained defendant Dahn & Krieger Architects Planners PC ("D & K") to provide architectural services. D & K's responsibilities related only to the design of the building. NMF's agreement with D & K stated that "[t]he building footprint and shell shall be in general conformance" with Sparaco's site plan. D & K proposed changes to the design and footprint of the building so as to make a smaller building, which changes required a modification of the prior footprint and related conforming changes to the site plan.

Sparaco offered to prepare an amended site plan for an additional payment. NMF rejected the offer and assigned the responsibility of creating an amended plan to defendant Lawler Matusky & Skelly Engineers LLP ("LMS"). Defendant Thomas B. Vanderbeek, an LMS employee, served as the primary engineer on the project. In order to accommodate D & K's new building design and footprint, LMS and Vanderbeek made several digital modifications to Sparaco's plan, including adjustments to the "utility connections" and "proposed gradings." NMF submitted the amended site plan to the Ramapo Planning Department. The amended site plan included the legend, "This site plan [is] based on [an] approved plan set entitled 'Heritage House' by A.R. Sparaco, Jr. . . ."

According to a senior official of the Ramapo Public Works Building Department, "This revised plan was basically

a copy of the approved A.R. Sparaco plan with several minor changes." It included "no change to the parking layout, lighting plan and only minor variations to the sedimentation and erosion control plan and the landscaping plan." The amended plan also copied "Sparaco's boundary survey, topographical contour lines, parking lot and shape, location of driveway, and curbs, and . . . the original building front from Sparaco's approved site plan." With the use of the amended site plan, the Heritage House project, eventually known as "Fountain View at College Road," was completed by November 1998.

B. Proceedings Below

Sparaco's complaint alleged that defendants copied his site plan to create a derivative work in violation of the Copyright Act, and falsely designated the origin of the amended plan in violation of the Lanham Act and New York State laws against unfair competition. The complaint also alleged that NMF and Klein breached their 1993 agreement with Sparaco by using his site plan without his written authorization.

After receiving a Report & Recommendation from Magistrate Judge Lisa Smith, *see Sparaco v. LMS et al.*, No. 97 Civ. 6270 (S.D.N.Y. May 14, 1999), the district court at first (1) dismissed all claims against D & K and G & A; (2) granted summary judgment to defendants on the unfair competition claims under the Lanham Act and state law; (3) denied summary judgment to NMF, Klein, LMS, and Vanderbeek on the copyright infringement claim; and (4) denied summary judgment on the breach of contract

claim against NMF and Klein. *See Sparaco v. LMS et al.*, 60 F. Supp. 2d 247, 250 (S.D.N.Y. 1999).

As to the contract claim, the district court ultimately found that the contract terms were unambiguous and that Sparaco was entitled to summary judgment. *See Sparaco v. Lawler, Matusky, Skelly, et al.*, No. 97 Civ. 6302 (S.D.N.Y. Sep. 14, 1999). On June 5, 2001, NMF, Klein, and Sparaco settled the contract claim.

As to the copyright claim against D & K and G & A, the district court understood Sparaco to allege that the redesign of the building amended his site plan, thus resulting in infringing derivative works—the amended site plan and the building. The court found that neither D & K nor G & A committed infringement, as Sparaco had no copyright interest in the design of the building. The court ruled that "[i]t does not infringe on a surveyor's copyrighted site plan to design a building that will require a revised site plan. And it does not infringe a surveyor's copyrighted site plan for a builder to construct that building from revised site plans that were commissioned and prepared by someone else." Deeming Sparaco's claims against D & K and G & A objectively unreasonable, the court awarded them attorneys' fees and costs.

As to the other defendants, the court denied summary judgment on the copyright infringement claim. The court found that although much of Sparaco's site plan contained "standard cartographic conventions to create a map of existing features of a piece of property," it also contained more creative elements that may deserve protection, including

the siting of the building, the resulting displacement contours, and the original design and siting of the parking lots and lighting fixtures.

Following this decision, the parties submitted various motions to the district court. On August 25, 2000, the district court disposed of these motions. It began by correcting its prior understanding of Sparaco's role in the development of the site plan. Further discovery had revealed that Sparaco's personal contribution to the site plan was substantially less than the court and the defendants originally believed. Most of the contribution to the site plan was by Schunkewitz, Meckler, and Torgerson. However, one month after the district court's first opinion—in September 1999—Sparaco had procured from Schunkewitz, Meckler, and Torgerson a written "Assignment of Copyright," pursuant to which all three contributors assigned their right, title, and interest in the drawings to Sparaco.

Citing our recent decision in *Attia v. Society of the New York Hospital,* 201 F.3d 50 (2d Cir. 1999)—issued after the district court's first opinion—the court ruled that the elements of Sparaco's site plan which it previously found potentially infringed—the siting of the building footprint, parking lot, utilities, light poles and trees, and proposed grading plan—were generalized conceptual ideas, not protected expression. It concluded that the Heritage House project "*could not* have been constructed from Sparaco's drawings, because they did not include any architectural details at all—just the placement of various features that would eventually be incorporated into architectural and construction drawings." *See Sparaco v. LMS et al.,* No. 97 Civ. 6270 (S.D.N.Y. Aug. 25, 2000). The court therefore dismissed Sparaco's copyright claim.

Appendix A

DISCUSSION

Sparaco contends the district court erred in concluding under *Attia* that copying the site plan would take nothing that is protected by copyright. As noted, Sparaco's site plan contains renderings of two types of features: (1) the existing physical characteristics of the site; and (2) proposals for physical improvements to the site. We discuss them separately because these two categories are governed by somewhat different copyright principles.

A.

Sparaco contends that his depiction of the existing characteristics of the site falls within the Copyright Act's protection either of maps, *see* 17 U.S.C. § 101 (defining "pictorial, graphic, and sculptural works" to include maps), or original compilations, *see* 17 U.S.C. § 101 ("A 'compilation' is a work formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship."). *See Mason v. Montgomery Data, Inc.*, 967 F.2d 135, 142 (5th Cir. 1992) (noting that although "[h]istorically, most courts have treated maps solely as compilations of facts," they may also qualify for protection as "pictorial, graphic, and sculptural works"); 1 William F. Patry, *Copyright Law & Practice* 247-48 (1994) (noting that "authorship in a map may consist of compilation or pictorial authorship, or a combination of the two").

Sparaco's argument would have had considerable force at an earlier time in the development of the copyright law. Since the eighteenth century, the copyright statutes have explicitly named maps as falling within their protection. *See, e.g.,* Copyright Act of May 31, 1790, ch. 15, § 1, 1 Stat. 124, 124 (1790) (repealed 1831) (providing that the "authors of any map [or] chart . . . shall have the sole right and liberty of printing, reprinting, publishing and vending such map [or] chart . . ."); *see also* 1 Patry at 247 (noting that copyright protection of maps enjoys a "venerable pedigree"). Copyright's early protection of factual information found justification in the author's labor or "sweat of the brow" in assembling and creating a work. In 1845, Justice Story explained that the maker of a map was protected against copying; another was free to map the same region but was not free to copy information set forth on the first map; he needed to rely on his own labor, skill, and expense to make a second independently conceived map. *Emerson v. Davies,* 8 F. Cas. 615, 619, F. Cas. No. 4436 (C.C.D. Mass. 1845); *see also Farmer v. Calvert Lithographing, Etc., Co.,* 1 Flip. 228, 8 F. Cas. 1022, 1026 (No. 4,651) (C.C.E.D. Mich. 1872) (in a case alleging infringement of map of Wisconsin and parts of nearby states, noting that "no one has the right to avail himself of the enterprise, labor and expense of another in the ascertainment of those materials, and the combining and arrangement of them, and the representing them on paper"); *Blunt v. Patten,* 3 F. Cas. 763, 765, F. Cas. No. 1580 (C.C.S.D.N.Y. 1828) (No. 1580) (copyright in navigation chart is violated "when another copies from the chart of him who has secured the copyright, and thereby availing himself of his labor and skill"); *see also* David B. Wolf, *Is There any Copyright Protection for Maps after Feist?,* 39 J. Copyright

Soc'y, U.S.A. 224, 227-28 (1992) (observing that historically copyright's protection of maps derived from the "sweat of the brow" doctrine—which justified protection on the grounds of "the physical effort exerted to get the raw data needed for the map"); Jane C. Ginsburg, *Creation and Commercial Value: Copyright Protection of Works of Information,* 90 Colum. L. Rev. 1865, 1875 (1990) (noting that American and English copyright decisions in the eighteenth and nineteenth centuries "characterized copyrightable authorship in terms of the labor invested in the work"); Robert A. Gorman, *Copyright Protection for the Collection and Representation of Facts,* 76 Harv. L. Rev. 1569, 1572 (1963) ("It is no doubt true that most of the early cases dealing with map copyright referred to the requirement of original effort in exploring, surveying, making inquiries, and drafting the map solely on the basis of one's own investigations.").

However, in its twentieth century development, copyright law turned away from that view. Courts began to repudiate the earlier notion that an author's labor in discovering facts justified giving the author protection against the copying of those facts. *See, e.g., Int'l News Serv. v. Associated Press,* 248 U.S. 215, 234, 63 L. Ed. 211, 39 S. Ct. 68 (1918) (denying copyright protection to factual information contained within a newspaper article). The view developed that historical, scientific, or factual information belongs in the public domain, and that allowing the first publisher to prevent others from copying such information would defeat the objectives of copyright by impeding rather than advancing the progress of knowledge. *See* U.S. Const. art. I, § 8, cl. 8 (assigning Congress the power "[t]o promote the Progress of Science

and useful Arts . . ."); *see also Hoehling v. Univ. City Studios, Inc.*, 618 F.2d 972, 979 (2d Cir. 1980) (holding that historical facts are not protected by copyright); *Miller v. Univ. City Studios, Inc.*, 650 F.2d 1365, 1372 (5th Cir. 1981) (criticizing sweat of the brow justification for copyright). In *Feist Publications, Inc. v. Rural Telephone Service Company*, 499 U.S. 340, 347-48, 113 L. Ed. 2d 358, 111 S. Ct. 1282 (1991), the Supreme Court further explained that copyright protection can extend only to original authorship, and that the publication of facts, regardless how much effort was expended in discovering them, is not original authorship. The facts set forth in an author's writing were not created by an author's act of authorship, and are therefore not protected by copyright. *Id.* at 348.

To the extent that the site plan sets forth the existing physical characteristics of the site, including its shape and dimensions, the grade contours, and the location of existing elements, it sets forth facts; copyright does not bar the copying of such facts. *See id.* at 350-51 ("Facts, whether alone or as part of a compilation, are not original and therefore may not be copyrighted. A factual compilation is eligible for copyright if it features an original selection or arrangement of facts, but the copyright is limited to the particular selection or arrangement."); *see generally* Pierre N. Leval, *An Assembly of Idiots?*, 34 Conn. L. Rev. 1049, 1056-58 (2002).

This does not completely dispose of Sparaco's claim relating to his representation of existing factual characteristics of the site. Although a mapmaker is not protected from copying of the factual information conveyed in the map, she is protected from the copying of any

originality in the manner of expression employed in communicating the factual information. Without doubt, considerable skill and originality can be exercised by a mapmaker in the setting forth of unprotected information—in the selection or elimination of detail, the size, shape, and density of informative legends, the establishment of conventions relating to color or design to represent topographical or other features, and many other details of presentation. *See Streetwise Maps, Inc. v. Vandam, Inc.*, 159 F.3d 739, 747-48 (2d Cir. 1998) (noting that the only aspect of a map entitled to copyright protection is its "original material," including the "overall manner in which [the author] selected, coordinated, and arranged the expressive elements in its map, including color, to depict the map's factual content"); *Mason*, 967 F.2d at 142 (extending copyright protection to land survey maps depicting topographical features because they "possess[ed] sufficient creativity in both the selection, coordination, and arrangement of the facts that they depict, and as in the pictorial, graphic nature of the way that they do so"); *see also County of Suffolk, New York v. First American Real Estate Solutions*, 261 F.3d 179, 188 (2d Cir. 2001).

The defendants, however, submitted evidence that the particular site plan employs standard cartographic features without originality, and Sparaco failed to submit evidence giving rise to a material issue of disputed fact rebutting this evidence. The district court was accordingly justified in concluding that the defendants were entitled to summary judgment as to the site plans to the extent they identify existing factual information about the site.

Appendix A

B.

In addition to representing existing physical features of the site, the site plan also includes proposed physical improvements. As to those elements, the district court denied copyright protection for a different reason. It relied on our decision in *Attia* to conclude that these depictions were conceptual ideas of a general nature, insufficiently detailed to be utilized in construction of the building. On that basis, the district court determined that the defendants' copying took only ideas, which are categorically denied copyright's protection.

In *Attia*, the plaintiff, an architect, alleged that New York Hospital and architects it had engaged infringed his copyright by making architectural plans that took elements from drawings he submitted for the modernization and expansion of the hospital's facilities. Attia's drawings focused on the development of a new building that would be constructed on a platform over a wide riverside highway. He alleged that the defendants infringed by taking a number of elements from his proposed designs, including: use of truss technology to transfer the weight of the new building spanning F.D.R. Drive; integration of the new structure with the pre-existing buildings by aligning the new floor heights to mesh with the old; alignment of the new building's corridors with the existing corridor to provide smooth internal traffic flow; insertion of a connecting roadway between 68th and 70th streets to make a continuous traffic loop through the hospital complex; and the general location of various hospital functions and services within the new facility. We held that there was no copyright infringement because the elements

assertedly taken by the defendants from the plaintiff's drawings were limited to "concepts and ideas." *Attia*, 201 F.3d at 55.

We found that Attia's drawings were "highly preliminary" and at a "very general level of abstraction." *Id.* They consisted essentially of ideas for the expansion of the hospital-vague and general notions relating to placement of elements, traffic flow, and use of engineering technologies. It is a fundamental principle of copyright law that "[i]n no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation [or] concept." 17 U.S.C. § 102(b). *See Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487, 489 (2d Cir. 1960) (L. Hand, *J.*); *Nichols v. Univ. Pictures Corp.*, 45 F.2d 119, 121 (2d Cir. 1930) (L. Hand, *J.*); 4 Melville B. Nimmer & David Nimmer, *Nimmer on Copyright* § 13.03[B][2] at 13-58 (1998). It is only if the copier has taken the author's expression or realization of the idea that infringement results. Where copying has occurred, the question whether there has been infringement can thus turn on whether the copying was only of the author's generalized ideas and concepts or of the author's more precisely detailed realization of those ideas. *See Nichols*, 45 F.2d at 121.

We concluded in *Attia*, even assuming the defendants had taken plaintiff's ideas, that such a copying of vague generalized notions did not constitute an infringement of copyright. There had been no taking of any detailed realization or expression of those ideas. *See Attia*, 201 F.3d at 55-56.

Appendix A

Relying on *Attia,* the district court ruled that the site plan's indication of new proposed elements—the building footprint, the contour of the parking lot, the location of curbs, fire lanes, utilities, light poles, trees, grading and contours—like Attia's proposals, fell into the category of unprotected ideas, rather than protected expression or realization of ideas. The district court stressed that "[n]ot only was the plan not sufficiently detailed to enable construction" but it "did not include any architectural details at all—just the placement of various features."

We respectfully disagree with the district court's analysis. In our view, the site plan was significantly different from Attia's proposal of ideas for the expansion of the hospital. Sparaco's site plan specifies more than vague, general indications of shape and placement of the elements. It provides detailed specifications for preparation of the site. Of course, the district court was correct that the site plan includes no architectural details and thus could not be used to construct the intended building. But the site plan was not intended as a plan for the construction of a building. It was a plan only for the preparation of the site. As such, it appears to be a fully realized plan capable of being used to guide actual construction work on numerous site preparation tasks, such as:

- preparation of the building footprint, including specific indentations in the layout of the building and designations for loading areas, common areas, and placements of utility structures;

- creation of parking lots, including precise details such as the distance between the lots and fences, the exact number of spaces, designations of spaces for the handicapped, distances between spaces, and dimensions;

- creation of drives, curbs, and walkways;

- displacement contours and elevation measurements resulting from the construction of the building, parking lots, and other structural additions;

- placement of utilities such as gas meters, drains, sewers, hydrants, and transformers;

- creation of fire lanes, fences, walls, and security gates;

- landscaping, including details as to the number, type, and placement of different trees, plants, and lighting fixtures;

- creation of sediment and erosion control measures, including water shelters, stabilized construction entrances, inlet protections, silt fences, earth dikes, and catch basins.

We note that Ramapo's Director of Building, Planning, and Zoning provided an affidavit, in which he stated, "The Albert R. Sparaco plan was acceptable to the Town and could have been built as approved." Ramapo's Director of Public Works

offered a similar assessment, indicating that Sparaco's site plan "was a very detailed plan . . . upon which the shown project could have been built in conformity with all of . . . Ramapo's codes and regulations."

We do not mean to imply that technical drawings cannot achieve protected status unless they are sufficiently complete and detailed to support actual construction. The question at what point an idea, too vague or abstract to warrant copyright protection, becomes sufficiently concrete or detailed to constitute protected expression is the endlessly baffling subject of Judge Learned Hand's famous abstractions discussion in *Nichols,* 45 F.2d at 121. We do not suggest it can be reduced to a simple bright-line test.

Recognizing that the site plan was not an architectural plan for a building but only a plan for the preparation of a site, we conclude that it did not consist only of the kinds of general ideas that we ruled in *Attia* were not protected from copying. It included specific expression and realization of those ideas, with the consequence that copying could constitute an infringement of copyright. We therefore vacate the judgment of the district court to the extent that it granted judgment for the defendants relating to copying of the site plan's specifications for site improvement.[2]

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2. By making this ruling, we do not imply that plaintiff can necessarily perfect his claim of copyright infringement, much less that he can show damages in the event he succeeds in proving infringement. We note that plaintiff brought separate claims for infringement of copyright and for breach of his contractual rights. The claim in contract was for breach of Sparaco's contractual

(Cont'd)

Appendix A

CONCLUSION

The judgment of the district court is VACATED and REMANDED for further proceedings.

(Cont'd)
entitlement that the site plan would not be copied, reproduced or adapted without his consent, and that he would be employed and paid for any amendment that might be undertaken. That claim was settled. It therefore appears that Sparaco was compensated for defendants' unpermitted copying and their failure to use his services in amending the plan. If those losses have already been compensated, it is not easy to see what further damages might remain available for copyright infringement.

In addition, we reject Sparaco's contention that the district court erred in granting summary judgment to defendants D & K and G & A and awarding attorneys' fees.

APPENDIX B — OPINION OF THE UNITED STATES DISTRICT COURT FOR THE SOUTHERN DISTRICT OF NEW YORK DATED AND DECIDED AUGUST 25, 2000

UNITED STATES DISTRICT COURT FOR THE SOUTHERN DISTRICT OF NEW YORK

97 Civ. 6270 (CM)(LMS)

ALBERT R. SPARACO, JR.,

Plaintiff,

-against-

LAWLER, MATUSKY, SKELLY ENGINEERS LLP, THOMAS VANDERBEEK, NORTHERN METROPOLITAN FOUNDATION, MORRIS KLEIN, DAHN & KRIEGER ARCHITECTS PLANNERS PC, and GRAHM & ALEXANDER,

Defendants.

August 25, 2000, Decided

OPINION

MEMORANDUM DECISION AND ORDER

McMahon, J.:

Copyright infringement cases are seldom straightforward. This one is less so than most.

Appendix B

Last year, the Hon. Lisa Margaret Smith, and then this Court, issued lengthy decisions in connection with motions to dismiss or for summary judgment that were filed by all Defendants in this action. Normally, I would refer the reader to the statement of facts that was painstakingly prepared by Magistrate Judge Smith, and adopted by me, before launching into a discussion of the legal issues presented by the cross-motions pending before me: Defendants' motion to dismiss for lack of subject matter jurisdiction and Plaintiff's cross-motion for relief from judgment pursuant to Fed. R. Civ. P. 60. However, it appears that a not insubstantial number of the "facts" in that statement of "facts" are incorrect, or at least imprecise. So let me start again.

I. FACTUAL BACKGROUND

Unless otherwise stated, the facts set forth below are undisputed.

Plaintiff, Albert Sparaco, is a land surveyor. In or about 1989, he was retained by two architectural firms, Albert R. Schunkewitz and Partners ("Schunkewitz") and Jerome Meckler Associates ("Meckler") to coordinate preparation of a Site Plan for a proposed adult living community to be built in the Town of Ramapo in Rockland County, New York. The two architects had been hired by Defendant Northern Metropolitan Foundation. ("NMF"), which owned the site and planned to develop the project. Plaintiff in turn retained Robert Torgersen, a landscape architect, to provide various site planning services. The project was originally known as Heritage House and eventually came to be called Fountain View at College Road.

Appendix B

Prior to retaining Sparaco, the architects prepared "conceptual sketch architectural drawings" (Letter from Albert R. Sparaco, Jr., to Albert Schunkewitz & Partners dated December 28, 1993) that, *inter alia*, identified the footprint for the building and its surrounding parking areas (i.e., the drawings showed those portions of the site on which those features would appear). According to Torgersen, these architects' drawings already showed 90-95% of the design of the topography. The architects forwarded their drawings to Plaintiff, who in turn retained Torgersen to assist him in preparing a set of detailed Site Plan drawings that would be acceptable to the authorities in the Town of Ramapo. Torgersen and his son (also an architect) refined the architects' work "to make the dimensions work with the topography." (Torgersen Dep. at-30). While Plaintiff discussed the Torgersens' work with them, Torgersen and his son did the actually drawings, on the basis of work previously performed by the architects. According to the previously cited December 28, 1993 letter prepared by Plaintiff, Torgersen also "did the grading on this project." (Letter from Albert R. Sparaco, Jr. to Albert Schunkewitz & Partners dated December 28, 1993).

Contrary to the Court's understanding, which was based on representations made to this Court by Plaintiff's counsel at an earlier point in this case, Sparaco himself did not propose the location of the trees, prepare the grading for the site, or propose the location of curbs or utility lines. Torgersen did. (Torgersen Dep. at 72-73). Sparaco does not dispute this. Rather, he says that he hired Torgersen to do this work and supervised his subcontractor. Plaintiff testified that he eventually made several changes to Torgersen's drawings — resiting one light pole, placing a small cluster of trees, adding

a security gate, drawing in some "no parking" stripes, designating where handicapped parking spaces might be situated, placing one curb and one electrical transformer, designating "grasstone" on the fire lanes (already sited) and reducing the size of a circular island near the building's entrance (an element designed by someone else). (Sparaco Dep. at 68-9, 118). The impetus for these changes did not originate with Plaintiff; rather, it appears that most, if not all, of Sparaco's changes were made in response to suggestions by representatives of the Town. (Sparaco Dep. at 74-75, 122-23, 258, 280, 465474). Plaintiff then compiled the Site Plan — a 14 page document — signed it, and filed it with the Town of Ramapo.

Plaintiff registered the copyright in the final Site Plan drawings, obtaining a Certificate of Copyright in December 1996. The registered drawings are dated December 23, 1993, and are the very drawings referred to in the December 28, 1993 letter cited above — the letter in which Plaintiff himself stated that Schunkewitz "prepared conceptual architectural sketch drawings" that showed the location of key elements of the project and that Torgersen "did the grading for this project." Nonetheless, Plaintiff listed himself as the sole "author" of the drawings in Part 2 of Form VA, the Copyright application form. He confirmed this by checking a box under Part 8 of the form certifying that he was the "author."

Plaintiff did not consult with counsel prior to filling out the copyright registration form. He had no formal legal or copyright training at the time he registered its copyright. He used words as a layman would. He claimed authorship based on the fact that he had compiled the fourteen-page Site

Plan, assembling all the pieces and arranging them into a form that would be acceptable to the Town of Ramapo, as well as adding elements to the various pages of the plan that had been prepared by his employees or his subcontractor, Mr. Torgerson, as described above. All this was based on the original design and siting that had been done by the architects. As Mr. Sparaco put it most eloquently in his testimony at the hearing, "When I said I was the author of the site plan, I meant it the same way General Grant meant it when he said, 'I defeated Lee at Richmond.'"

In Part 4 of the same form, Sparaco also indicated that he was the "copyright claimant." Significantly, the form states that the copyright claimant need not be the same person as the author, and a claimant can assert a copyright in that capacity without being the author (*see also*, Part 8, Certification, which contains a box for "copyright claimant" as opposed to "author.")

Plaintiff did not attach to his application any documents by which Meckler, Schunkewitz or Torgersen purported to assign any right, title and/or interest they might have had in the design of the Site Plan. At least as to Meckler and Torgersen, there were no such documents, and for a perfectly understandable reason. Meckler, who has worked regularly with Plaintiff on various projects for over 20 years, and who has a high opinion of him as an engineer, took the position that, as between him and Sparaco, any drawings that were prepared, signed and sealed by Sparaco were the latter's responsibility and belonged to him. Similarly, any drawings prepared by his (Meckler's) firm were his responsibility and belonged to him. Since Sparaco had prepared and signed the

drawings at issue (regardless of the source of the information depicted on those drawings), they were Sparaco's as far as Meckler was concerned. (Tr. of Hearing dated August 10, 2000). Sparaco and Torgerson, like Sparaco and Meckler, also worked together frequently. As between themselves, Sparaco and Torgerson had the understanding that the prime contractor on a particular job was the owner of the drawings for that job. On this particular project, Sparaco had retained Torgerson's services and thus, pursuant to their common understanding, was the "owner" of the drawings.

When registering the copyright in the drawings, Plaintiff also did not file any document that satisfied the requirements of Section 101 of the Copyright Act of 1976 pertaining to work for hire. Nor did he identify the drawings as "compilations," though they would appear to have been precisely that.

Despite the fact that his personal contribution to the drawings was far less than either Judge Smith or I had been led to believe, Plaintiff's application for copyright could hardly have taken anyone by surprise. Meckler, who originally brought Plaintiff into the project, was fired by the developer in 1991, when financial constraints brought work to a standstill. In 1992, the project moved forward again, with Schunkewitz as the sole architect, and during 1992 and 1993, he used Plaintiff as his surveyor. Apparently not enjoying the same close and long-standing relationship with Sparaco that Meckler enjoyed, Schunkewitz and NMF insisted on a formal, written contract with Plaintiff. On or about July 15, 1993, Plaintiff entered into a contract between himself, Schunkewitz and NMF (represented by Defendant Morris Klein), which provided, *inter alia*, as follows:

Appendix B

The survey notes, worksheets, plans, document and drawings are instrumentalities of the service being provided for use solely for this particular project or application and shall remain the property of the surveyor. The client shall be permitted to retain copies for information and reference in connection with the Client's use of the property surveyed, designed or planned. The drawings shall only be used by the Client for the purpose for which they are prepared, unless the parties agree otherwise in a written and signed instrument and with appropriate compensation to the Surveyor. *The parties hereto acknowledge that the surveyor is the author of the drawings and documents and shall retain all common law, statutory and other reserved rights, including the United States Copyright law, 17 U.S.C. § 101 et seq., and thereby retains sole ownership of the copyright in and to the drawings. In recognition of the Surveyor's claim to ownership and copyright, the Client shall not copy, reproduce, or adapt the drawings or engage in any other activity which would violate the copyright therein without the Surveyor's written consent. To do so shall be deemed a material breach of this contract.* The surveyor's drawings, plans or other documents shall not be used by the client, owner, or any other party for additions to this project or for the completion of this project by others, except by a separate agreement in writing, and with appropriate compensation to the Surveyor. Submission of distribution of maps, documents, etc., to meet

> official regulatory requirements, or for similar purposes in conjunction with this particular project is not to be construed as publication in derogation of the surveyor's reserved rights. (Emphasis added)

This Court has previously had occasion to construe this "rather straightforward" contract provision, *Sparaco v. Lawler et al.*, 60 F. Supp.2d 247, 257 (S.D.N.Y.), and has held (1) that it is unambiguous; (2) that as between NMF, Schunkewitz and Plaintiff, it vests ownership and copyright in the Site Plan drawings in Plaintiff; and (3) that any copying or other use of the drawings by NMF or Schunkewitz (or their agents) to complete the project without Plaintiff constitutes a material breach of the contract unless the parties enter into a written agreement that compensates Plaintiff for that use. *Id.* Just so it is clear, nothing contained in the expanded record now before me has caused me to alter my construction of the contract in the slightest.

This project appears to have generated more than its share of troubled relationships: Schunkewitz was fired from the project in 1996. He settled with NMF for $ 20,000 and signed a document assigning all his right, title and interest in the project to NMF,[1] and NMF retained Defendant Dahn & Krieger Architects ("D&K") to complete the project.

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1. Of course, by virtue of the July 1993 agreement, Schunkewitz had no copyrightable interest in any of the drawings, as he had agreed to give that to Sparaco. Therefore, the purported assignment to NMF is of highly questionable value.

Appendix B

Finding numerous errors in the existing Site Plan, D&K hired its own surveyor, Defendant Lawler, Matusky, Skelly Engineers LLP ("LMS") to revise the plans. LMS created the amended Site Plan that constitutes the allegedly infringing work in this action. There is no dispute, and there has never been any dispute, that Defendant Thomas B. Vanderbeek, an LMS engineer, incorporated portions of the existing Site Plan drawings into the revised Site Plan. *See Id.* Indeed, he has testified that he traced parts of the document. (Vanderbeek Dep. at 121.)

This Court has already granted summary judgment to Sparaco declaring that this copying by LMS breached the provision of 1993 contract between Plaintiff and NMF as set forth above. *See Id.* I have further ruled that this claim is not preempted by the Copyright Act. *Id.* Accepting the recommendations of Magistrate Judge Smith, this Court dismissed the copyright infringement and Lanham Act claims as against D&K and the architect who redesigned the building, Graham & Alexander ("G&A"), because neither of them had "copied" the Site Plan. However, overruling the Magistrate Judge, I concluded that there were disputed issues of material fact concerning both originality and infringement that would necessitate a trial on that issue as between Plaintiff on the one hand and the new surveyors (LMS) and the developers (NMF) on the other:

> Plaintiff has at least suggested that his site plan contained certain creative elements, including his siting of the building and the resulting displacement contours (which are not natural to the site), as well as an original design for and siting of

> features adjacent to the building such as a parking lot, and lighting fixtures. Defendants insist either that these lack originality or that their amended site plan did not actually copy those elements of Plaintiff's map, but I cannot tell on this record whether those arguments have merit. Accordingly, we will take this issue to trial.

Sparaco 60 F. Supp.2d at 252. Since all the pending motions had been filed prior to the taking of any discovery, I ordered that discovery proceed.

A year has passed, and the matter only gets "curiouser and curiouser." Lewis Carroll, Alice's Adventures in Wonderland, 18 (Wanderer Book ed. 1982). Approximately one month after I issued my first opinion, and a full two years after he filed this action, Plaintiff paid a visit to Messers. Schunkewitz, Meckler and Torgersen. He procured from each of them a signature on a document entitled "Assignment of Copyright," pursuant to which each of those three contributors to the creation of the Site Plan gave up his right, title and interest in the drawings to Plaintiff.

Subsequently, each of those three individuals was deposed. In those depositions, Defendants' counsel learned for the first time what Mr. Sparaco had and had not "created" with respect to the Site Plan drawings. At his deposition, Torgersen candidly admitted that Plaintiff had hardly anything to do with the creation of the drawings. (Torgersen Dep. at 31-32, 34, 37, 39, 41.) In particular, Torgersen testified that Sparaco had little or nothing to do with creating those features in the drawings that Plaintiff's counsel had argued

were the "original" elements in the Site Plans (*see* Defendants' Hearing Exhs. 46 and 47.)

Several weeks later, Plaintiff's counsel forwarded "corrections" to the deposition transcript. Among the "corrections" was a statement that Torgersen had entered into an oral agreement assigning his interest in the work to Plaintiff at or about the time Torgersen did the work. This, of course, is not a "correction" to the transcript at all, but the injection of a wholly new element, one that originally appeared to have been latterly dreamed up by an increasingly desperate Plaintiff's counsel. That initial misimpression has been cleared up, and now that I understand how matters stood between Messers. Sparaco and Torgersen, I can appreciate why their arrangement might have been characterized as an "oral assignment." However, this description is not precisely accurate (although I find no fault with Torgersen for any lack of precision).

Schunkewitz and Meckler both testified at their depositions that no agreement existed regarding the ownership rights at issue apart from the September 1999 assignments of copyright. (Schunkewitz Dep. at 34; Meckler Dep. at 98.) Indeed, Schunkewitz originally testified that his firm owned the drawings. (Schunkewitz Dep. at 31.) Thereafter Plaintiff's counsel sent "corrections" to Schunkewitz' testimony as well, which included a statement that ownership of the Schunkewitz/Meckler drawings had been transferred to Plaintiff via the above-quoted provision from the 1993 contract.

Defendants' discovery of the "truth" about Plaintiff's "authorship" of the drawings spawned the first motion before

me: a motion to dismiss the copyright claims asserted by Sparaco for lack of jurisdiction, on the ground that his copyright registration was fraudulently obtained and that the assignments that Sparaco procured after the commemcement of this lawsuit were not effective *nunc pro tunc*. Thus, they argued, Sparaco had no standing to sue for infringement. Plaintiff disputes that he obtained his registrattion fraudulently, citing the extremely lenient standard applied by the courts where allegations of fraud on the Copyright Office are asserted, and argues in the alternative that (1) the 1993 contract provision operates as an assignment from Schunkewitz; (2) Torgersen, Schunkewitz and Meckler "orally assigned" their interest in any copyright to him many years ago, and the 1999 documents merely formalized the matter; and (3) the 1999 documents are effective *munc pro tunc*.

Plaintiff, meanwhile, has moved for relief from the judgment entered by the Clerk of the Court on Aug. 11, 1999, dismissing D&K and G&A from this action, on the ground that LMS' admitted copying of his copyrighted drawings rendered D&K's re-designed building a violation of Plaintiff's copyright under the derivative work doctrine, and that G&A's construction of the building designed by D&K also violated the copyright. These very arguments have already been rejected by this Court, which previously ruled that the record contained no evidence that *D&K* or *G&A* actually "copied" the Site Plan drawings. Nothing in Mr. Vanderbeek's testimony about his tracing elements of the drawings impacts on that conclusion in the slightest, since all Vanderbeek's testimony does is establish that *LMS* had copied the drawings.

Finally, the Court injected its own new issue, by asking counsel to address the question of whether the Second Circuit's recent opinion in *Eli Attia v. The Society of the New York Hospital*, 201 F.3d 50 (2d Cir. 1999) — which came down after last summer's decision on the motions to dismiss — warranted revisitation of my prior conclusion that there were disputed issues of fact concerning the originality of the drawings. Defendants argue that Attia compels dismissal of the copyright claims on the ground that the Site Plan is not copyrightable; Plaintiff contends that Attia is both factually and legally distinguishable from this case.

II. SUMMARY OF DECISION

(1) The Defendants' motion to dismiss for lack of subject matter jurisdiction is denied.

(2) The Second Circuit's opinion in Attia resolves the issue of copyrightability in favor of Defendants and mandates dismissal of Plaintiff's remaining federal cause of action.

(3) The Court elects to exercise supplemental jurisdiction over what remains of the complaint — the breach of contract claim against NMF, as to which liability has already been found.

Appendix B

III. DISCUSSION

A. This Court Has Subject Matter Jurisdiction Over the Claims in Suit

Possession of a valid copyright registration is a jurisdictional prerequisite to an infringement action, and creates a rebuttable presumption that the work in question is copyrightable. *See* 17 U.S.C. §§ 410(c)-(d), 411(a). This presumption is not overcome by an "innocent misstatement" in a registration application, but may be overcome by proof of a deliberate misrepresentation. *See Eckes v. Card*, 736 F.2d 859, 861 (2d Cir. 1984); M. Nimmer & D. Nimmer, 2 Nimmer on Copyright § 7.20 at 7-198 (1998)(hereinafter "Nimmer"). The law in this Circuit is that "only the knowing failure to advise the Copyright Office of facts which might have occasioned rejection of the application constitute[s] reason for holding the registration invalid and thus incapable of supporting an infringement action." *Eckes* 736 F.2d at 859 (citing *Russ Berrie & Co., Inc. v. Jerry Elsner Co., Inc.*, 482 F. Supp. 980 (S.D.N.Y. 1980).

A party seeking to establish fraud on the Copyright Office bears a heavy burden. *See* Nimmer § 7.20 [B] at 7-207. Indeed, under this doctrine, courts have excused virtually all types of errors on Copyright registrations. Courts have forgiven Plaintiff's for having misidentified the author of a work, *see Thomas Wilson v. Irving J. Dorfman Co.*, 433 F.2d 409 (2d Cir. 1970) (listed president of corporation instead of corporation); *Testa v. Janssen*, 492 F. Supp 198 (W.D. Pa. 1980) (listed author's assignee), or for having misidentified the owner of the copyright, *see Wales Indus. v. Hasbro*

Bradley, Inc., 612 F. Supp. 510 (S.D.N.Y. 1985) (listing as copyright claimant the exclusive licensee). *See also Original Appalachian Artworks v. Toy Loft, Inc.*, 684 F.2d 821 (11th Cir. 1982) (holding that mention in a registration certificate of only one of two co-authors does not affect the validity of the registration).

The party asserting fraud must establish that the application for copyright registration is factually inaccurate and that the inaccuracies were willful or deliberate. *See Whimsicality v. Rubie's Costume*, 891 F.2d 452, 455 (2d Cir. 1989). Moreover, some courts have also required a party alleging fraud on the Copyright Office to prove that it has been prejudiced, or suffered some damage, as a result of the alleged fraud. *See* S.O.S., *Inc. v. Payday*, 886 F.2d 1081, 1086 (9th Cir. 1989). And as with all motions to dismiss, for purposes of a motion to dismiss, the complaint must be viewed in the light most favorable to the Plaintiff, and all well-pleaded factual allegations taken as true. *See Conley v. Gibson*, 355 U.S. 41, 45-46, 2 L. Ed. 2d 80, 78 S. Ct. 99 (1957).

Based on the record before me, including the testimony taken at a hearing on the merits of this application on August 10, 2000, I cannot conclude that any misrepresentations (if they were misrepresentations) contained in Sparaco's copyright application were willful or deliberate. Mr. Sparaco is a layperson, not a lawyer. He filled out his own copyright form. While the Copyright Office goes to great lengths to make its forms "user friendly," the distinctions between concepts like "author" and "claimant" or "joint work" and "compendium" are not obvious to those not initiated in the arcana of copyright law. Complicating matters is the fact that

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Sparaco had a good faith basis for believing that he had some copyrightable interest in the Site Plan, based on the July 15, 1993 contract between him and Schunkewitz, which certainly operates as an assignment of any copyright that Schunkewitz might have had in the drawings. Finally, the fact that others besides Sparaco may have been entitled to the copyright as co-authors or co-claimants is not something that would have led the Copyright Office to reject Sparaco's application, in view of the Copyright Office regulations that clearly allow one to supplement a registration in which one or more co-authors or co-claimants have been omitted. *See* 37 C.F.R. § 201.5(b). Thus, I decline to invalidate the copyright registration for fraud.

In support of their motion to dismiss, Defendants rely heavily on *Raquel v. Education Management Corp.*, 196 F.3d 171 (3d Cir. 1999), a Third Circuit decision that invalidated a copyright due to fraud. Defendants claim that Raquel states that "misstatements as to authorship have been held to be a material mischaracterization sufficient to void a registration". (Memorandum of Law in Further Support of the LMS Defendants' Motion to Dismiss Pursuant to Fed. R. Civ. P. 12(b)(1), Mar. 22, 2000.) But the mischaracterization in Raquel concerned the nature of the copyright, not its authorship. The Raquel court took pains to stress this point after distinguishing the "forgiving" cases, cited *supra*. The court stressed that in those cases, the registrant had the right to the work described in the registration form, which wasn't the case for the Raquel Plaintiff's, who had no copyrightable interest in the work that it registered. In Raquel, the plaintiff registered a copyright to an "audiovisual work" though it was undisputed that it only had an interest in the

song that was used in the audiovisual work. "A copyright registration that misidentifies the nature of a copyrighted work fails to give proper notice to the register of copyrights regarding the nature of the intellectual property for which protection is sought." *Id.* at 179. Defendants do not claim that Sparaco is guilty of misrepresenting the nature of the work. Further, Sparaco, unlike the Raquel Plaintiff's, had a copyrightable interest in the work that he registered, by virtue of the July 15, 1993 contract with Schunkewitz. It should be noted that the brief for Defendant changes the work "nature" to the word "authorship" when paraphrasing the Raquel case; this is particularly the distinction that the case makes.

The Raquel court also distinguished *Harris v. Emus Records Corp.*, 734 F.2d 1329 (9th Cir. 1982). In Harris, the court determined that a registration form incorrectly identifying singer EmmyLou Harris as the author of a work did not bar Harris' infringement suit where subsequent transfers resulted in Harris' ownership of the copyright before suit was instituted and the defendant showed no prejudice from the misidentification of the author. Here, Sparaco claims that Torgersen and Meckler orally assigned him their rights in any copyright years ago, and that the "Assignments of Copyright" that he procured from them as of late merely formalized the matter. As a technical matter, this is not correct. Neither Torgersen nor Meckler orally assigned anything to Sparaco at the time the work was done (they never even discussed the matter), but only because it never occurred to them that they had anything to assign. Under their standard business arrangement, all rights in the Site Plan already belonged to Sparaco. However, as a legal matter, the Copyright Act requires that transfer of copyright ownership

be made in writing. This can be done contemporaneously (as was the case with Schunkewitz) or by an oral assignment later ratified or confirmed by a written memorandum of transfer. *See* 17 U.S.C. sec. 204(a). In this Court's opinion, the understanding about ownership and copyright that arose from the regular course of dealing among Messers. Sparaco, Torgersen and Meckler is the equivalent of an express oral assignment, and all that zealous (perhaps nervous) counsel did last September was memorialize that understanding. Therefore, I conclude that Sparaco had a valid assignment of Torgersen's and Meckler's copyright interest (as well as Schunkewitz') prior to his institution of this action.

Because I do not find that Sparaco committed fraud on the Copyright Office so as to nullify his ability to maintain suit for infringement, I deny Defendants' motion to dismiss for lack of subject matter jurisdiction.[2]

However, this will prove a hollow victory for Plaintiff.

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2. Although the Court was not correctly advised of the nature of Plaintiff's contribution to the Site Plan, and although there have been some rather tortured scramblings to try to rectify any problems with the copyright registration that were created thereby, I wish to make it quite clear that I am not leveling charges of any sort against counsel for Plaintiff. It is the opinion of this Court that counsel had a good faith basis for taking the factual positions that they took on the initial motions in this matter, in view of the existence of the registration and the July 15, 1993 contract. (I can only surmise what they were told by their client, but I am not going there.) Furthermore, whatever actions have been taken by Plaintiff or by Plaintiff's counsel since last September were, in the opinion of this Court, undertaken by counsel to try to clarify a murky situation. It was, perhaps, inherent

(Cont'd)

Appendix B

B. Plaintiff's Cause of Action for Copyright Infringement is Insufficient under *Attia v. New York Hospital*

In their reply memorandum on the motion to dismiss for lack of subject matter jurisdiction, the NMF Defendants state, "As the Court is aware, defendants contend that none of the material in question is copyrightable to begin with. This motion assumes arguendo that the material is copyrightable and seeks dismissal based on Plaintiff's lack of standing to assert such copyright." (NMF Reply Brief at 2, n.3) It turns out that the assumption of copyrightability, which Defendants derive from this Court's opinion of last August, is unwarranted.

On December 27, 1999, the Second Circuit decided *Eli Attia v. The Society of the New York Hospital*, 201 F.3d 50 (2d Cir. 1999). The case concerned the copyrightability of certain preliminary drawings for an addition to New York Hospital. The addition as ultimately built included the distinctive element of a new wing constructed on a platform located over the F.D.R., or East River, Drive. Plaintiff Eli Attia, an architect, was without question the first person to prepare drawings that included this distinctive element.

(Cont'd)

in the mess created by Mr. Sparaco's naivete that the purported "corrective" measures only made things murkier. And perhaps counsel overreacted — though my initial reaction to the news that Mr. Sparaco was not the "creator" of the allegedly original elements in the Site Plan was identical to Defendants', namely, I thought that misrepresentations had been made. On sober reflection, however, I find the Plaintiff and his counsel guilty of nothing more than idiomatic imprecision, which is hardly a mortal sin.

The Hospital's board of governors embraced the idea, and when they held their design competition, the competing architects were instructed to tailor their proposals of a "major new construction on the air rights over the F.D.R. Drive with connections to renovated existing facility." 201 F.3d at 52. Of course, plaintiff did not win the competition; indeed, his firm failed to make the first cut. When he learned that the winning plans included a new building over the F.D.R. Drive, he filed suit in this District, alleging, inter alia, infringement of his copyright. The District Court (Rakoff, J.) awarded summary judgment to defendants, on the ground that Plaintiff's original design for the project and the winning design were "not substantially similar." *Attia v. Soc'y of New York Hospital*, New York 1998 U.S. Dist. LEXIS 6338, No. 95 Civ. 3021, 1998 WL 226167, (S.D.N.Y. May 5, 1998). Attia appealed.

The Second Circuit affirmed Judge Rakoff"s decision, but on the ground that the elements of Attia's drawings that had been copied (in some cases, traced) by the winning architect were not copyrightable in the first place.

Speaking for the Court, Judge Leval stated, "There are elements of a copyrighted work that are not protected even against intentional copying. It is a fundamental principle of our copyright doctrine that ideas, concepts and processes are not protected from copying." *Attia* 201 F. 3d at 54 (citations omitted). While acknowledging that it was sometime difficult to distinguish between an uncopyrightable "idea" and its copyrightable "expression" — particularly where the work "is of a functional nature, as is a plan for the accomplishment

of an architectural or engineering project," *id.* at 55, Judge Leval went on to state the following principle:

> As a generalization, to the extent that such plans include generalized notions of where to place functional elements, how to route the flow of traffic, and what methods of construction and principles of engineering to rely on, these are "ideas" that may be taken and utilized by a successor without violating the copyright of the original "author" or designer. On the other hand, to the extent that the copier appropriates not only those ideas but the author's personal expression of them, infringement may be found. *Id.*

Applying that principle to the facts before it, the Court of Appeals concluded that "the similar elements that Defendants assertedly copied from Plaintiff's drawings" were not "protected matter." *Id.* Those elements included:

> (1) placement of the new structure over the F.D.R. Drive in the same location;
>
> (2) use of a 3 story high truss to transfer the weight of the new building to rows of columns spanning either side of the highway;
>
> (3) integration of the new structure with the pre-existing buildings by aligning the new floor heights to mesh with the old;

(4) alignment of corridors in the new building with the pre-existing corridors to provide smooth internal traffic flow;

(5) insertion of a connecting roadway between 68th and 70th Streets to make a continuous traffic loop through the hospital complex;

(6) placement of emergency services on the new connecting roadway, with ambulance entrance and parking adjacent;

(7) placement of diagnostic and treatment functions on the lower floors of the new building and nursing on the upper floors;

(8) placement of a new main pedestrian area in the same location in the new building;

(9) placement of a mechanical floor in the same location in the new building arrangement of nursing floors using a long rectangular corridor divided into thirds by placement of support care stations, with patient rooms surrounding the exterior of the corridor;

(10) the "unique combination" of all of the above design elements. *Id.* at 55-56.

This list of elements covers virtually the entire design scheme for the project — where the building would go, where the various facilities within the building would go, how it

would be integrated with existing features (in this case, existing buildings and streets), where the parking would be located, how traffic would be routed. Yet despite the fact that all these design features conceptually originated with plaintiff and were subsequently incorporated by the winning architect into its design, the Court held that there had been no infringement of *copyrightable* expression. The reason was that these features

> are no more than rough ideas of general nature. They are barely a first step toward the realization of a plan. How these and other ideas would be expressed or realized in a finished plan is not even approached in Plaintiff's drawings. *Id.* at 56.

The Court distinguished the many precedents cited by Attia to support his claim of infringement by observing:

> In each of these cases, architects sued for copyright infringement and prevailed; in each, however, the misappropriated architectural plans, unlike Plaintiff's, consisted of drawings that were sufficiently detailed to enable construction. (*Id.*)

And while the panel stated, "We do not mean to suggest that, in the domain of copyrighted architectural depictions, only final construction drawings can contain protected expression," *id.* at 57, Judge Leval held:

> Plaintiff's drawings in this case, however, at least to the extent copied, consisted only of generalized ideas and concepts pertaining to the Placement of

> elements, traffic flow, and engineering strategies. The allegedly copied matter consisted only of ideas and concepts, not of protected expression. *Id.*

Having dismissed plaintiff's claim of copyright infringement as against the architects for their winning drawings, the Court of Appeals also sustained dismissal of an infringement count against one particular architect, who made some rough freehand sketches that plaintiff contended were traced from his drawings (i.e., his "expression"). The panel agreed with Attia that this architect (Winkelman) might well have copied portions of Plaintiff's drawings by tracing them. "Nonetheless," the Court held:

> we reject Plaintiff's claim with respect to Winkelman's sketches for reasons similar to those elaborated above. Even assuming Winkelman copied from Plaintiff's drawings, what he copied was not protected matter. Some of the allegedly copied lines are simple statements of existing facts, such as the location of existing walls . . . Other arguably copied lines take nothing more than a general idea, such as the eastward extension of the Hospital's 68th Street entrance (so as to be able to join a ramp and roadway connecting with 70th Street). For all the reasons explained above, the copying of such an idea or concept is not protected by the copyright law. *Id.* at 58.

Viewing the facts in this case against the backdrop of Judge Leval's opinion in Attia, it seems clear that the very elements in the Site Plan that Plaintiff claims to be "original"

to him (or his subcontractors) — the siting of the building's footprint and the parking lot, the location of the curbs, fire lanes, water lines, the light poles and trees, the grading and contours (similar to the engineering elements that were contained in Plaintiff's drawings)[3] — are precisely the sorts of elements that the Second Circuit would hold to be "ideas" as opposed to "expression," to the point where even tracing them (as Defendant Vanderbeek is alleged to have done) would not constitute copyright infringement. Plaintiff's drawing is, in essence, a map of the site. It does not even show the building that was to be constructed thereon. Not only was the plan not "sufficiently detailed to enable construction," *id.* at 56, but — contrary to the somewhat hyperbolic statement by Plaintiff's counsel — the project *could not* have been constructed from Sparaco's drawings, because they did not include any architectural details at all — just the placement of various features that would eventually be incorporated into architectural and construction drawings. As such, the Site Plan must be viewed as even less eligible for protection than were Attia's preliminary drawings, which showed numerous architectural details.

Plaintiff's efforts to distinguish the facts in Attia from those before me are unavailing. In support of its proposition that "courts have consistently held that all types of building

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3. It appears that Plaintiff is not even claiming that the contours and grading are eligible for copyright protection (Sparaco Dep. at 100-102), although his counsel certainly so argued to the Court last spring (Transcript of July 23 oral argument, attached to Defendant's Affirmation in Support of its Reply to Plaintiff's Opposition to the Motion to Dismiss of March 21, 2000 as Ex. 2, page 67).

plans (e.g., engineering, schematic, preliminary, floor, and construction) are copyrightable," Plaintiff cites a list of cases readily distinguishable from the facts of the instant matter. Indeed, the first of those cases was itself distinguished by Judge Leval in his opinion in Attia. *See Eales v. Environmental Lifestyles, Inc.*, 958 F.2d 876 (9th Cir. 1992). In Eales, the Plaintiff's drawings, unlike Sparaco's, were model home construction plans sufficiently detailed to enable construction; the same could be said of the engineering drawings at issue in *Guillot-Vogt Associates v. Holly & Smith Architects*, 848 F. Supp. 682 (E.D. La. 1994). At issue in *Johnson v. Jones*, 921 F. Supp. 1573 (E.D. Mich. 1996), were "preliminary design drawings," but the designation "preliminary" was in name only; they were architectural plans from which one could build a structure. The "house plans" of *Richmond Homes Management, Inc. v. Raintree, Inc.*, 862 F. Supp. 1517 (W.D. Va. 1994), *rev'd on other grounds*, 66 F.3d 316 (4th Cir. 1995), similarly, were copyrightable architectural plans. In *I.A.E. v. Shaver*, 74 F.3d 768 (7th Cir. 1996), the court made no finding as to the copyrightability of the "schematic design drawings" at issue in that case, as no party raised a challenge to the validity of those drawings; this is hardly support for Plaintiff's argument.

Plaintiff argues forcefully that site plans are, or should be, copyrightable. This Court is not suggesting that, in an appropriate case, they are copyrightable. However, remembering that this Court was on the verge of dismissing the copyright claim a year ago — only to pause when Plaintiff's counsel listed elements of the Site Plan that were not mere representations of the existing landscape — Plaintiff is bound by those representations as to what elements in the Site Plan

are sufficiently "original" to qualify for copyright protection. Examining that list against Attia, the conclusion that nothing in this Site Plan qualifies for copyright protection — regardless of the amount of labor Plaintiff, his employees and his subcontractors put into the work — is virtually inescapable.

Because Attia disposes of the issue of copyrightability, it is not even necessary to address Defendants' alternative argument that there are substantial differences (and, hence, no substantial similarity) between the allegedly infringing elements on the amended Site Plan and on Plaintiff's original. The claim of copyright infringement is dismissed as against all Defendants. I note that this ruling provides a further reason to deny Plaintiff's motion for relief form the judgment of dismissal as against G&K and D&A.

C. The Breach of Contract Claim

This leaves Plaintiff's claim for breach of contract. Since I have found that this Court does have subject matter jurisdiction, and since I have gone so far on this state law claim as to find an indisputable breach of the contract, I elect to exercise supplemental jurisdiction over it. NMF may submit a memorandum of no more than 10 double spaced pages, without footnotes, in support of its argument that, as a matter of contract law, a breach of the 1993 contract by Plaintiff (in the form of sloppy workmanship, which necessitated the preparation of a new Site Plan) constituted the breach of a dependent covenant that would permit Defendant to breach the covenant against copying the drawings. LMS may submit a similarly sized memorandum explaining why Vanderbeek's admitted copying does not

render it liable for breach of contract in its capacity as NMF's agent. Plaintiff may submit a twenty-page memorandum (ten pages per issue, same rules) explaining why NMF and LMS are wrong. Defendant's memoranda are due on September 8; Plaintiff's on September 22. The Court will then decide what, if anything, remains to be tried other than Plaintiff's damages for breach of contract, and against whom that trial will proceed.

This constitutes the decision and order of the Court.

Dated: August 25, 2000

Colleen McMahon

U.S.D.J

APPENDIX C — OPINION OF THE UNITED STATES DISTRICT COURT FOR THE SOUTHERN DISTRICT OF NEW YORK DATED SEPTEMBER 14, 1999

UNITED STATES DISTRICT COURT FOR THE SOUTHERN DISTRICT OF NEW YORK

97 CIV. 6302 (CM)

ALBERT R. SPARACO, Jr.,

Plaintiff,

-against-

LAWLER, MATUSKY, SKELLY et al.,

Defendants.

September 14, 1999, Decided

OPINION

SUPPLEMENTAL DECISION AND ORDER

McMahon, J.:

The various matters before me are disposed of as follows:

1. The Court finds that the "extra element" necessary to avoid federal Copyright Act preemption of a State law contract case is present in this case, for the reasons set forth in the letter from plaintiff's counsel dated September 13, 1999, to wit: the contract at issue here includes elements in addition to a mere promise not to reproduce, including an

agreement that any additions to the initial project by persons other than plaintiff can be made only pursuant to a separate written contract that provides for compensation to the plaintiff for the use of his work. Accordingly, the plaintiff's Fourth Cause of Action, for breach of contract, is not preempted.

2. The NMF defendants' motion for reconsideration is denied for the reasons set forth in plaintiff's memorandum in opposition to the motion. Plaintiff is awarded summary judgment on the issue of liability on the Fourth Cause of Action. The question of damages will be taken up at the trial.

3. I have received a copy of a notice of appeal, which I understand was served and filed by plaintiff. The notice purports to appeal all portions of my order of August 12, 1999, even those that, while dispositive as to some issues in the case, are not appealable as a matter of law (*see* 28 U.S.C. §§ 1291 and 1292). My views concerning plaintiff's application for a "preliminary injunction" requiring defendants to pay them money, the urgency of which was never pressed (by mandamus or otherwise) when injunctive relief might have been considered, are on record in my opinion and need not be restated here. However, plaintiff can deal with that question before the Court of Appeals. I simply want the parties to be on notice that the notice of appeal does not stay their obligation to be ready for trial this fall. The minimal amount of discovery needed to take this rather uncomplicated matter to trial on the few questions that remain can be accomplished within 60 days. However, because a clerical error at the Court meant that certain parties

did not receive copies of the August 12 opinion and order to more than two weeks, I am extending the date for filing pre-trial submissions from October 28, 1999 until December 1, 1999.

This constitutes the decision and order of the Court.

Dated: September 14, 1999

Colleen McMahon

U.S.D.J.

APPENDIX D — OPINION OF THE UNITED STATES DISTRICT COURT FOR THE SOUTHERN DISTRICT OF NEW YORK DATED AND DECIDED AUGUST 11, 1999

UNITED STATES DISTRICT COURT FOR THE SOUTHERN DISTRICT OF NEW YORK

97 Civ. 6270 (CM)(LMS)

ALBERT R. SPARACO, JR.,

Plaintiff,

-against-

LAWLER, MATUSKY, SKELLY, ENGINEERS, LLP, THOMAS B. VANDERBEEK, NORTHERN METROPOLITAN FOUNDATION, MORRIS KLEIN, DAHN & KRIEGER ARCHITECTS PLANNERS P.C. and GRAHAM & ALEXANDER,

Defendants.

OPINION

DECISION AND ORDER ACCEPTING IN PART AND REJECTING IN PART THE REPORT AND RECOMMENDATION OF THE HON. LISA MARGARET SMITH

McMahon, J.:

On May 14, 1999, I received a thorough Report and Recommendation from the Hon. Lisa Margaret Smith in the

trade name infringement, unfair competition and breach of contract, brought by a surveyor whose site plan for a building site in the Town of Ramapo, New York was superseded by an allegedly infringing copy. I have received objections from all parties, and on July 23, the parties appeared before me to argue their various motions. Upon review of the record, I have decided to accept Judge Smith's recommendations in part and reject them in part, in accordance with this decision.

STATEMENT OF FACTS

Magistrate Judge Smith prepared an excellent statement of undisputed facts, which I adopt as my own. For ease of reading, I incorporate it here.

Plaintiff, Albert R. Sparaco, Jr., entered into a contract with Defendants Northern Metropolitan Foundation for Health Care, Inc. ("NMF"), and its Executive Director, Morris Klein ("Klein"), under which Plaintiff was to survey the site for Heritage House,[1] a proposed development. *See* Contract dated July 15, 1993, attached as Ex. A to Plaintiff's Order to Show Cause. In addition to surveying the site, Plaintiff also created a site plan for which he obtained a Certificate of Copyright Registration in December, 1996. *See* Aff. of Albert Sparaco dated Feb. 11, 1999, ¶¶ 4-10; Ex. B. attached to Am. Comp. The site plan consisted of a depiction of the grade and contours of the land, a proposed location for the building, and the proposed location of utilities. Plaintiff's site plan is dated December 22, 1993. *See* Ex. A. attached to Am. Compl.

1. Heritage House is now known as The Fountain View at College Road.

This site plan was filed with the Town of Ramapo, New York.[2] *See* Am. Compl., ¶ 13.

Klein and NMF hired Defendant Dahn & Krieger ("D & K"), to redesign the building in May, 1996. *See* Aff. of William Dahn dated Nov. 25, 1998 ("Dahn Aff."), attached to Dkt. # 27, ¶ 3; Dahn Aff. dated Feb. 25, 1999, ¶ 4. As a result of the redesign, the footprint of the building changed.[3] *See* Dahn Aff. 2, ¶ 6. As a further result, the site plan prepared by Plaintiff and filed with the Town required amendment. *See* Dahn Aff. 2, ¶ 6.

In 1997, Defendants Klein and NMF contracted with Defendant Lawler, Matusky & Skelly Engineers, LLP ("LMS"), and one of its partners, Defendant Thomas Vanderbeek ("Vanderbeek"), to amend the site plan. *See* Affidavit of Thomas Vanderbeek ("Vanderbeek Aff"), dated Nov. 30, 1998, ¶¶ 3-4. In completing that project, LMS and Vanderbeek "digitized" contours from Plaintiff's site plan onto the amended site plan because the land had already been disrupted by the early stages of construction. *See* Vanderbeek Aff. ¶ 4. The amended site plan by LMS and Vanderbeek, dated June 13, 1997, indicates that it is based on a previously approved site plan by Plaintiff. *See* Ex. C attached to Am. Compl.; Ex. B. attached to Order to Show Cause. It is undisputed that on July 27, 1997, LMS and Vanderbeek's

2. Plaintiff asserts that the site plan was filed, but does not provide the actual date of that filing. (Am.Compl.¶ 13). None of the Defendants contradict Plaintiff's assertion.

3. The footprint of the building is the shape or outline of the building on the surface of the land. (*See* Sparaco Aff. ¶ 9).

site plan was also filed with the Town of Ramapo. *See* Vanderbeek Aff., ¶ 4.

Defendants Klein and NMF contracted with Defendant Graham & Alexander ("G & A"), to construct the building. *See* Aff. of Leonard Kohl dated Dec. 10, 1998, ¶ 3. That construction was completed by November, 1998. *See* Declaration of Morris Klein, ¶ 3. LMS and Vanderbeek are currently in the process of preparing and filing an "as built" survey and site plan. *See* Aff. of Thomas Vanderbeek, dated Jan. 22, 1999, ("Vanderbeek Aff. 2"), ¶ 4, attached to Dkt. # 40, as Ex. 3.

Plaintiff filed this action on August 22, 1997, alleging copyright infringement, unfair competition under the Lanham Act, unfair competition under New York law and breach of contract. The breach of contract claim appears to be alleged as against Defendant Klein alone. In the Amended Complaint, Plaintiff asserts the following as relevant to all of his claims:

> 15. Some time after Plaintiff Sparaco completed the *Heritage House* Work and it was filed with the Town of Ramapo, New York, Defendants NMF, Klein, D & K, and G & A asked Plaintiff Sparaco to provide an estimate of his services to update the *Heritage House* Work. Upon information and belief, Defendants . . . then decided not to engage Plaintiff Sparaco and, instead, engaged Defendant LMS.
>
> 16. Upon information and belief, after Plaintiff Sparaco published the Heritage House Work,

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> Defendants infringed said copyright by copying and causing to be filed in the office of the Clerk of the Town of Ramapo **a derivative work** (hereafter the "Derivative Work") comprising a substantial copy of the Heritage House Work."

Am. Compl. ¶¶ 15-16 (emphasis supplied).

The original complaint was filed against LMS and Vanderbeek on August 22, 1997. Plaintiff amended his complaint on November 3, 1997, to include NMF and Klein, architects D & K, and builders G & A. Plaintiff filed an Order to Show Cause why a Preliminary Injunction should not Issue, on April 23, 1998.[4] Defendants responded to that motion and subsequently filed motions to dismiss and for summary judgment, as well as various supporting papers. Defendant G & A filed an Affidavit joining in co-defendants' various motions.

In November 1998, shortly after I took the bench here in White Plains, I conferenced this case and learned that it had been in limbo for some time. I sent it to Magistrate Judge Smith for a Report and Recommendation concerning

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4. The Motion for Preliminary Injunction and Memorandum of Law were prepared by Plaintiff's counsel in October, 1997. The Honorable Barbara S. Jones, United States District Judge, issued the Order to Show Cause on November 3, 1997. However, these documents were not filed in the Clerk's office until April 23, 1998. Defendants began to respond to the motion in May and June, 1998. The motion has been pending all the time, but as no temporary restraining order was requested during the pendency of the motion, construction of the building continued during this period. It was completed long ago.

plaintiff's motion for a preliminary injunction and defendants' various motions for summary judgment. As noted above, after reviewing the voluminous record and hearing the parties, she issued a 23 page Report on May 14, 1999.

Rather than summarize the Report, I will deal with each recommendation *seriatim.*

CONCLUSIONS OF LAW

1. Copyright Infringement

Plaintiff's first cause of action, asserted against all defendants, alleges that Defendants "have been copying and making the Derivative Work and, upon information and belief, otherwise selling, and/or otherwise marketing the copyrighted Heritage House Work . . . ." Am. Compl. ¶ 21. The derivative work referred to varies, it would seem, depending on which defendant is being sued. As to Defendants LMS and Vanderbeek ("the Surveyor Defendants") the derivative work is indisputably their amended site plan. As to Defendants D & K (the designer of the new building) and G & A (the builder of the new building), the derivative work is apparently the building itself, which plaintiff alleged at oral argument to be an infringing derivative work. As to Defendants NMF and Klein ("the Developer Defendants"), the derivative work is both the site plan and the building that was eventually constructed.

I have no difficulty agreeing with the learned Magistrate Judge that the First Cause of Action must be dismissed as against D & K and G & A. Plaintiff's theory is that, because

the redesigned building necessitated amending the site plan, which resulted in the creation of an infringing derivative work (the amended site plan), the building constitutes an infringing derivative work and its designer and builder can be sued for copyright infringement. This is nonsense. Plaintiff is not an architect. He never designed any building. He designed a site plan to accommodate a building designed by someone else. When the building's developers decided they wanted to change the building, they hired a new architect (D & K) who redrew the building. That appears to have required changes in the original site plan. But plaintiff had no guarantee, under either the copyright laws or his contract with Klein, that the building for which he designed his site plan would be built or that his plan would be used with any other building. Indeed, plaintiff's contract expressly forbade use of his site plan with any other building (see *infra.*) Plaintiff's only right (if he had any right) was a **copy**-right — that is, a right to keep others from making copies of his original work. As long as the new architect and the builder who carried out the architect's vision did not make copies of Plaintiff's copyrighted work (i.e., his site plan), they did not violate his **copy**-right.

As the Magistrate Judge correctly found, there is no evidence in this record that either D & K or G & A either copied or caused anyone else to copy plaintiff's work. There is also no evidence that D & K or G & A sold or otherwise marketed Sparaco's site plan. Neither does plaintiff allege that these two Defendants directly profited from any infringing activity — or, for that matter, that they were even aware that the other defendants might be infringing Sparaco's copyright. The profits they received for redesigning the

building and constructing it — while associated with and resulting from the project — did not emanate directly from the allegedly infringing activity. To the contrary, the allegedly infringing activity (the creation of an amended site plan) emanated from the redesign of the building.

With respect to the other defendants, the question is far from clear. In order for Plaintiff to succeed in his action for copyright infringement, he must show that he holds a valid copyright and that Defendants copied elements of his work that are copyrightable. *See Feist v. Rural Tel. Serv. Co., Inc.*, 499 U.S. 340, 362, 113 L. Ed. 2d 358 (1991). A certificate of registration from the Copyright Office is prima facie evidence of the validity of the copyright, but the court maintains discretion over how much weight that certificate should be given. *See* 17 U.S.C. § 410(c). An effective challenge to the copyright shifts the burden to the plaintiff to "prov[e] all of the multitude of fact underlying the copyright validity." *Carol Barnhart, Inc. v. Economy Cover Corp.*, 773 F.2d 411, 414 (2d Cir. 1985).

In *Feist*, the Supreme Court clarified the originality requirement for compilations, emphasizing that "originality, not 'sweat of the brow,' is the touchstone of copyright protection in directories and other fact-based works." 499 U.S. at 361. The Court did, however, recognize a low standard of originality. A work is original so long as it is "independently created by the author (as opposed to copied from other works), and . . . possesses at least some minimal degree of creativity." *Id.* at 345. The Court stated that "the vast majority of works make the grade quite easily, as they possess some creative spark, 'no matter how crude, humble or obvious' it might be." *Id.*

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In accordance with the *Feist* decision, the Second Circuit set three requirements for an original compilation: "(1) the collection and assembly of preexisting data; (2) the selection, coordination, or arrangement of that data; and (3) a resulting work that is original, by virtue of the selection, coordination, or arrangement of the data contained in the work." *Key Publications, Inc. v. Chinatown Today Pub. Enterprises, Inc.*, 945 F.2d 509, 511 (2d Cir. 1991). The Court later clarified the third prong of this test, explaining that "creativity in selection and arrangement . . . is a function of (i) the total number of options available, (ii) external factors that limit the viability of certain options and render others non-creative, and (iii) prior uses that render certain selections 'garden variety.'" *Bender v. West Publ'g Co.*, 158 F.3d 674, 682-83 (2d Cir. 1998).

This Circuit recently addressed the limits of the copyrightability of maps in *Streetwise Maps, Inc. v. Vandam, Inc.*, 159 F.3d 739 (2d Cir. 1998). Streetwise, a company that produces laminated tourist maps, claimed that another mapmaker had infringed its copyright. The court upheld Streetwise's copyright based upon the "expressive elements in its map, including color, to depict the map's factual content." *Id.* at 747. The court then found that Streetwise's competitor had not infringed upon that copyright because the two maps left "sufficiently different impressions" and thus were not "substantially similar." *See Streetwise* at 746-47. In deciding the infringement issue, the court noted that some of the similar elements of the maps were standard cartographic conventions. The Court also noted that there were substantial differences in the places of interest identified on the maps.

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Plaintiff attempts to distinguish its situation from the mapmaker's in *Streetwise* by noting that the only original elements of Streetwise's map were the colors and gridlines used. Plaintiff states that Streetwise is not relevant to the case at hand because it did not address "the copyrightability of: elevation measurements . . . used to develop land contours; renderings of specific terrain; measurements and renderings of underground facilities; outlines or footprints of buildings; plans for location of building features; plans for location of trees, curbs, and utility needs — all of the things Plaintiff's site map included." (Plaintiff's Objs. To Report of Magistrate Judge Smith at 8.) Plaintiff instead analogizes his case to *Rockford Map Publishers, Inc. v. Directory Service Company of Colorado, Inc.*, 768 F.2d 145, 149 (7th Cir. 1985), where the court held that a mapmaker who created plat maps showing the location, size and ownership of land was entitled to copyright protection because his work was a "new arrangement or presentation of facts." *Id.*

After oral argument, I am convinced that Judge Smith was correct when she concluded that there were genuine issues of material fact that would preclude summary judgment on this claim. Much of defendants' argument relies on plaintiff's use of standard cartographic conventions to create a map of existing features of a piece of property, and they are clearly correct when they argue that things like elevation measurements used to develop land contours "are not copyrightable — at least since the so-called 'sweat of the brow' theory of copyrightability has been rejected". However, plaintiff has at least suggested that his site plan contained certain creative elements, including his siting of the building and the resulting displacement contours (which

are not natural to the site), as well as an original design for and siting of features adjacent to the building, such as a parking lot and lighting fixtures. Defendants insist either that these lack originality or that their amended site plan did not actually copy those elements of plaintiff's map, but I cannot tell on this record whether those arguments have merit. Accordingly, we will take this issue to trial.

Defendants rely in the alternative on the merger doctrine, which holds that the expression of an idea — i.e., that which is normally copyrightable — may not be protected by copyright if there are so few ways of expressing the idea that the expression and the idea merge. As the Second Circuit has noted, the merger doctrine is difficult to apply. *See Kregos v. Associated Press and Sports Features Syndicate, Inc.*, 937 F.2d 700, 705 (2d Cir. 1991). In *Kregos*, the Court warned that the merger doctrine should not be applied too readily to factual compilations because the result would be that these compilations would never be copyrightable. *See id.*

A court's decision to apply the merger doctrine depends on how the court defines the author's idea. Because of this flexibility, the "'idea' should be defined with reference to 'the balance between competition and protection reflected in the patent and copyright laws.'" *Mason v. Montgomery Data, Inc.*, 967 F.2d 135, 140 (5th Cir. 1992) (quoting *Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738, 742 (9th Cir. 1971)). Hence, in deciding to give copyright protection to real estate maps, the *Mason* court focused on the mapmaker's creativity in selecting the sources it used, while the court in *Kern River Gas Transmission Co. v. Coastal Corp.*, 899 F.2d 1458 (5th Cir. 1990), focused on the monopoly that Kern River would be granted if its

competitors were prohibited from using the idea expressed by the company in its map.

Mason and Kern River illustrate the difficulty courts have in applying the merger doctrine. In Kern River, the plaintiff drafted a proposed pipeline route onto a published map and submitted that map to federal and state regulatory agencies for permission to build the pipeline. The court stated that the map they drew was the only effective way to depict the idea of the pipeline, and since the idea of the location was uncopyrightable, the map was, as well. *Id.* at 1463. Even though Kern River "conducted expensive and detailed field work to acquire the information needed to formulate mile-by-mile the precise location of their pipeline," *id.* at 1463, the Court held that "[t]o extend protection . . . would be to grant Kern River a monopoly of the idea for locating a proposed pipeline in the chosen corridor, a foreclosure of competition that Congress could not have intended to sanction through copyright law." *Id.* at 1464.

On the other hand, in *Mason*, the court held that the merger doctrine did not apply to real estate maps which showed the location, size, and shape of tracts of land as well as information about the owners because the plaintiff demonstrated that there were differences between Mason's maps and those of his competitors. The court felt that "each mapmaker's selection of sources, interpretation of those sources, discretion in reconciling inconsistencies among the sources, and skill and judgment in depicting the information" would result in maps that were different enough that the merger doctrine was not applicable. 967 F.2d at 138. The Mason court noted that the difference between their ruling and the one in Kern River was a result of their focus

on judgments made in gathering information, not the lines drawn on the map.

When considering the merger doctrine, a court must consider whether a subsequent compiler's work would be "substantially similar." *See Hart v. Dan Chase Taxidermy Supply Co., Inc.*, 86 F.3d 320, 323 (2d Cir. 1996) ("the merger inquiry asks whether *all* realistic fish mannequins, no matter how artistic they might be, will necessarily be 'substantially similar'"). Plaintiff is correct that the fact that Defendants' amended site plan (which was admittedly based on Plaintiff's original work) is substantially similar to the original map does not necessarily mean that all site plans would be substantially similar. However, this admission does not preclude the merger inquiry either. The merger doctrine applies if every mapmaker who created his or her own site map would create the same map and then be accused of copyright infringement by Defendant. *See Mason*, 967 F.2d 135, 138.

Defendants argue that the case at hand is similar to the facts of Kern River because Plaintiff's site map was the only effective way of expressing the ideas in the map in a way that the Town of Ramapo would accept, and to allow Plaintiff a copyright over the map would be to allow him a monopoly over the ideas expressed in the proposal. They also argue that Plaintiff has not brought forth evidence (as the Plaintiff in Mason did) showing that subsequent mapmakers maps would not necessarily by substantially similar to his map.

Plaintiff responds by distinguishing the facts of Kern River. He argues that his situation differs from the plaintiff in Kern River because rather than drawing a pipeline over

an existing map, he created the first map of the site. Plaintiff also states that if Defendants had drawn their own map they would have reached a different result because the skill and judgment that he used are similar to the mapmaker's in Mason. (*See* Plaintiff's Reply to Objections by Defendants at 9.)

It appears that some of the same issues of fact that impact on the originality argument — including whether there are alternative ways to express whatever it is that defendants borrowed from plaintiff's original site plan — would need to be resolved before I could rule on a merger doctrine claim.

Thus, the developer and surveyor defendants' motions for summary judgment on plaintiff's first cause of action are denied.

2. Lanham Act/Trade Name

Plaintiff's second claim arises because, under New York State Education Law § 7209(2) (McKinney's 1995), the surveyor defendants were required to state on their amended site plan that their work was based on Sparaco's approved plan. Therefore, when they filed their amended site plan, they included the legend, "This site plan [is] based on [an] approved plan set entitled 'Heritage House' by A.R. Sparaco, Jr. . . ." Plaintiff contends that, by retaining his name on the amended site plan, all defendants held out the surveyor defendants' work as Sparaco's (a "passing off" or false attribution claim). The complaint further asserts that defendants did this with the intention of confusing the public. At oral argument, it became clear that Sparaco fears that he will be sued by some resident or guest at the building because

his name appears on the most recent site plan, even though the design is no longer his.

I agree with the Magistrate Judge that plaintiff's claim here is for false attribution, and I also agree with her determination that it should be dismissed. Professor Nimmer tells us that ". . . no false attribution results, and the author accordingly may not object to the use of his name, if the work, although substantially altered, carries a sufficiently prominent notice indicating which portion in fact was written by others, or if the notice merely indicates truthfully that the work is based on or derived from the work of the author, but does not represent that it is created by or authorized by the author." 2 Nimmer on Copyright, § 8D.03[B][1] (1996). Since the legend on the surveyor defendants' amended site plan is no more than a truthful statement that their work is based on plaintiff's, it does not state a false attribution claim under the Lanham Act. Indeed, the very fact that plaintiff asserts that his work was used, but altered, makes the "based on" legend both true and legally inoffensive.

I also agree with Magistrate Judge Smith that plaintiff's failure to provide the court with any evidence of actual confusion or likelihood of confusion, or with any evidence that Mr. Sparaco's name has acquired distinctiveness via a secondary meaning, compels dismissal of his Lanham Act claim even if it be viewed as a claim for infringement of his trade name.[5] Mr. Sparaco should have assembled the

5. The Magistrate Judge did not distinguish among the various defendants when she recommended dismissal of this claim, and I am dismissing it as to all of them. Nonetheless, I note that there is no

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necessary information via his own expert witness or market surveys, even before the summary judgment motions were submitted. The fact that the motion sequence in this matter commenced with an application by Sparaco for a preliminary injunction — in support of which he was required to demonstrate likelihood of success on the merits of, *inter alia*, his trade name claim — suggests that Sparaco was well aware of this requirement and chose to hope that the Court would overlook it. If he was not aware of the requirement at the outset, the filing of summary judgment motions by the various defendants should have alerted him to it. This is not the sort of evidence that cries out for Fed.R.Civ.P. 56(f) relief, as it lies within plaintiff's power to obtain or generate evidence of secondary meaning or confusion; no such evidence in within defendants' control.

3. Unfair Competition under New York Law

Plaintiff's allegation that the use of his name in the "based on" legend on the amended plans constitutes unfair competition under New York trademark law is similarly deficient, as Judge Smith found. While New York's trademark law, Gen.Bus.L. § 360-l, does not require proof of actual or likelihood of confusion, as the corresponding Federal law does, it does require that the trademark either be distinctive or have acquired secondary meaning. It also requires proof of likelihood of dilution. As the learned Magistrate Judge noted, a mark that is primarily a surname may not be

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(Cont'd)

evidence to indicate that D & K or G & A either used plaintiff's name in any manner or were involved in arranging for others to use it, so no claim is stated against them regardless.

registered absent a showing of acquired distinctiveness, and personal names are treated by the common law as descriptive terms absent proof of secondary meaning. *Lane Capital Management, Inc. v. Lane Capital Management, Inc.*, 15 F. Supp. 2d 389, 394 (S.D.N.Y. 1998). Plaintiff's "mark" is his name — or, more precisely, his initials and his surname — and he has not offered any evidence of secondary meaning in order to show that his mark is distinctive. It was plaintiff's burden to offer evidence that his name and business had become synonymous in the mind of the public. He has not done so. other than to note that there is no other surveyor in this area by the name of Sparaco. This, with respect, does not constitute evidence of secondary meaning. Plaintiff's third cause of action is dismissed.[6]

4. Breach of Contract

Magistrate Judge Smith recommended that I deny the developer defendants' motion for summary judgment dismissing plaintiff's claim of breach of contract against them, on the ground that there are issues of fact for trial. Here I must part company with Judge Smith. The breach of contract claim presents only issues of contract construction, as the underlying facts are undisputed. I agree that the developer defendants' motion must be denied, but that is because plaintiff is entitled to summary judgment on his breach of contract claim — unless this cause of action is preempted by the Copyright Act.

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6. Again, Judge Smith did not bother to discuss the positions of the various defendant separately. I simply note that there is no basis for plaintiff to assert any claim against D & K or G & A, for the reasons set forth in the previous footnote.

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I note first that there would be no problem with my granting summary judgment against the developer defendants in response to their motion for summary judgment in their favor. A motion for summary judgment searches the record. If it is clear that all of the evidentiary material a party might submit in response to a motion for summary judgment are before the court, that there are no disputed issues of fact and that a non-moving party is entitled to judgment as a matter of law, the district court is free to enter judgment accordingly. *Ramsey v. Coughlin*, 94 F.3d 71, 73-74 (2d Cir. 1996); *Coach Leatherware Co. v. AnnTaylor, Inc.*, 933 F.2d 162, 167 (2d Cir. 1991).

This is such a case. The only issues implicated by defendant's summary judgment motion are what a certain term of the parties' contract mean and whether defendants' admitted use of some contours from plaintiff's original site plan in their amended site plan breaches any term of that contract. Contract construction presents a question of law, not of fact. *See Gonzalez v. Norrito*, 256 A.D.2d 440, 682 N.Y.S.2d 100 (1998) (citing *Ligator v. Continental Bank*, 152 A.D.2d 684, 544 N.Y.S.2d 23 (2d Dep't 1989); *Hartford Acc. & Indem. Co. v. Wesolowski*, 33 N.Y.2d 169, 350 N.Y.S.2d 895, 305 N.E.2d 907 (1973)). Since the surveyor defendants have never denied that they incorporated some of plaintiff's work into their site plan, there is no disputed issue of material fact. Either that action breaches the relevant contract term or it does not. Thus, defendants cannot be prejudiced by an entry of summary judgment against them.

Judge Smith concluded that there were issues of fact on the breach of contract claim because of a conflict between

the developer defendants' assertion that their filing of the LMS plans with the Town of Ramapo was authorized by Sparaco's contract and Sparaco's assertion that the contract authorized only the filing of his unaltered plans. However, as the parties' subjective intent is irrelevant and the words of the contract are unambiguous, I can resolve this dispute by construing the contract. And as I construe the contract, the developer defendants are wrong and plaintiff is right.

The contract at issue is a letter of agreement, entitled Agreement for Professional Services, dated July 15, 1993 and thereafter twice revised. it is on the letterhead of A.R. Sparaco, Jr., and it is addressed to Albert Schunkewitz & Partners, Architects, P.C. (the architects who designed the original building) The contract is signed by three parties: Sparaco, the architect and defendant Morris Klein, representing the owner/developer. It provides, in pertinent part, as follows:

> The survey notes, worksheets, plans, documents and drawings are instrumentalities of the service being provided for use solely for this particular project or application and shall remain the property of the surveyor. The client shall be permitted to retain copies for information and reference in connection with the Client's use of the property surveyed, designed or planned. The drawings shall only be used by the Client for the purpose for which they are prepared, unless the parties agree otherwise in a written and signed instrument and with appropriate compensation to the Surveyor. The parties hereto acknowledge that

> the surveyor is the author of the drawings and documents and shall retain all common law, statutory and other reserved rights, including the United States Copyright law, 17 U.S.C. § 101 *et seq.*, and thereby retains sole ownership of the copyright in and to the drawings. In recognition of the Surveyor's claim to ownership and copyright, the Client shall not copy, reproduce, or adapt the drawings or engage in any other activity which would violate the copyright therein without the Surveyor's written consent. To do so shall be deemed a material breach of this contract. The surveyor's drawings, plans or other documents shall not be used by the client, owner, or any other party for additions to this project or for the completion of this project by others, except by a separate agreement in writing, and with appropriate compensation to the Surveyor. Submission or distribution of maps, documents, etc., to meet official regulatory requirements, or for similar purposes in conjunction with this particular project is not to be construed as publication in derogation of the surveyor's reserved rights.

Sparaco contends that this document vests the both ownership of the drawings and copyright exclusively in him, prohibits defendants from using the drawings for any purpose except the one for which they were prepared, and prohibits any copying or adaptation of his drawings without his written consent. Sparaco also notes that the contract specifically prohibits the owner (Klein) or any other party from using

any of Sparaco's drawings or other work "for additions to this project or for the completion of this project by others" without his permission and without paying him additional compensation. He claims that the undisputed facts demonstrate that the developer defendants did all of the above, by (1) causing LMS to copy and adapt portions of the drawings, (2) for a project known as Fountain View (i.e., not for the purpose for which they were prepared, which was the original Heritage House project), (3) which was to be completed by others (i.e., a new architect, D & K, and new surveyors, LMS).

The developer defendants argue that they have done nothing in derogation of the contract, since the same paragraph that sets forth all the above-listed rights grants them permission to file the plans with the Town of Ramapo without violating plaintiff's copyright therein. They claim that is all they did — file the drawings with the Town, albeit in altered form. They reject Sparaco's contention that the plain meaning of the contract is that permission was limited to the filing of drawings, not unauthorized alterations to his drawings.

The plain meaning of the easy-to-understand words used in the contract is as follows:

(1) Defendants may not copy or alter Sparaco's drawings without his written consent.

(2) Any copying or alteration of those drawings constitutes a material breach of the contract.

(3) Defendants may not use plaintiff's drawings except for the purpose for which they were prepared.

(4) Filing the plans with the Town of Ramapo will not be deemed an unauthorized publication of the copyrighted documents.

As contracts go, this is rather straightforward. Plaintiff's intention to prevent defendants from copying or making alterations to his surveyor's drawings without his permission, and without payment to him of additional compensation, is quite clear. Defendants manifested their acquiescence to that provision by signing the document. They bound themselves by their signature not to do what they did — i.e., hire another surveyor and then permit him to modify plaintiff's pre-existing work for use on a revised project. Defendants did not have to grant plaintiff these rights as a matter of contract, but they did. They are bound by their bargain.

Defendants' argument that they did not breach the contract because of the provision that permits them to file the plans without violating plaintiff's copyright misconstrues the plain meaning of the contract. The purpose for which the drawings were prepared was the construction of a particular building, known as Heritage House and designed by a particular architect (the Schunkewitz firm). That building was never built. Another building, known as The Fountain View at College Road, designed by a different architect and necessitating an altered site plan, was constructed in its place. In light of the many clear and unambiguous contractual restrictions on copying or altering plaintiff's works — including the one that specifically prohibited any use of

plaintiff's work to make additions to the project or to allow others to complete it — the only fair reading of the "purpose for which they were intended" clause is that plaintiff granted the developer defendants permission to file his drawings and none other. Moreover, defendants cannot be heard to argue that under this clause are plaintiff's "reserved rights" his contract rights, since the sentence uses the term "publication" which is a term of art only in the copyright context. The only fair reading of a sentence that says "Filing will not be construed as publication in designation of your reserved rights" is "Filing my plans will not be deemed as unauthorized publication by you;" or, more simply, "You have a license to file my copyrighted plans." Any broader interpretation would vitiate plaintiff's carefully constructed contract rights.

As there is no disputed issue of fact concerning what LMS did by way of copying and altering portions of plaintiff's drawings, and as the language of the contract is unambiguous, I find that the developer defendants breached their contract with plaintiff.

However, that does not end the matter. Section 301 of the Copyright Act preempts any and all state law rights that "may be abridged by an act which, in and of itself, would infringe one of the exclusive rights provided by federal copyright law". *Computer Associates Int'l., Inc. v. Altai*, 982 F.2d 693, 716 (2d Cir. 1992). Of course, state law claims (such as breach of contract claims) are not preempted where the claim implicates an "extra element" beyond the acts of reproduction, performance, distribution or display. There is a split among my brothers and sisters in the District Court as to whether a breach of contract claim can never be preempted,

because the promise inherent in every contract automatically provides the "extra element," *see, e.g. Architectronics, Inc. v. Control Systems, Inc.*, 935 F. Supp. 425 (S.D.N.Y. 1996), citing *Nimmer on Copyrights*, § 1.01[B][1][a]; or whether a promise alone is insufficient to save a breach of contract claim that asserts only that defendants did something that is reserved to the holder of a copyright, *see American Movie Classics v. Turner Entertainment Co.*, 922 F.Supp. 926 (S.D.N.Y. 1996). The Second Circuit as not yet weighed in with its opinion on this question. It is, however, a question I need not reach, if, in fact, Sparaco's contract does more than merely prohibit defendants from derogating plaintiff's copyright (assuming he has one).

The parties have not briefed this issue — possibly because they, who are more familiar with the contract than I, do not see any preemption problem here — and so I will give them leave to do so. If I am convinced either that the Architectronics view is correct or that this contract gives Sparaco rights other than his copyright, then I will direct entry of judgment for plaintiff on his fourth claim, with damages to abide trial.

5. Motion for Preliminary Injunction

Plaintiff's motion for a preliminary injunction is denied, as there is no showing of irreparable injury. Obviously, it is too late to prevent construction of the building based on the allegedly infringing drawings, which is the injunctive relief plaintiff initially sought (I note that a balance of the equities would not have favored plaintiff's request even if it were still timely). The very injunction that plaintiff now suggests

would be appropriate — a mandatory injunction paying royalties to plaintiff *pendente lite* — is both inappropriate (as it gives plaintiff the ultimate relief he seeks) and demonstrates that any injury he has suffered can be compensated by money. Plaintiff's above-mentioned fear that he may be sued at some point in the future by someone who mistakenly assumes that his name on the revised plans renders him liable for defects in the site is purely speculative and therefore does not support the entry of so drastic a provisional remedy as a preliminary injunction — although, as noted at oral argument, it may support an award of indemnity if plaintiff ultimately prevails on his copyright claim.

6. Motions for Attorneys' Fees

Plaintiff's motion for attorneys' fees is denied as premature. Plaintiff has not yet prevailed on any claim for which statutory fees are authorized.

Pursuant to 17 U.S.C. § 505 (1996), a prevailing defendant in a copyright case may, in appropriate circumstances, be awarded attorneys' fees. *See Fogerty v. Fantasy, Inc.*, 510 U.S. 517, 127 L. Ed. 2d 455, 114 S. Ct. 1023 (1994); *Williams v. Crichton*, 891 F. Supp. 120, 121-22 (S.D.N.Y. 1994); *Agee v. Paramount Communications, Inc.*, 869 F. Supp. 209 (S.D.N.Y. 1994), *rev'd in part on other grounds*, 59 F.3d 317 (2d Cir. 1995); *Screenlife Establishment v. Tower Video, Inc.*, 868 F. Supp. 47 (S.D.N.Y. 1994). Such an award lies within the sound discretion of the Court. *See Fogerty*, 510 U.S. at 525. As this Court held in *Screenlife Establishment*, a court may award attorneys' fees to a defendant if the court finds that the plaintiff's claim was objectively unreasonable.

See 868 F. Supp. at 52. There need not be a finding of bad faith or frivolousness by the plaintiff. *See id. See, also, Williams*, 891 F. Supp. at 121-22 (awarding attorneys' fees to defendant because plaintiff's claim of copyright infringement was objectively unreasonable based upon the same findings that supported the defendant's motion for summary judgment); *Agee*, 869 F. Supp. at 209 (awarding attorneys' fees to defendant because plaintiff put forth no evidence in support of its motion to disqualify counsel).

Obviously, the surveyor and developer defendants are in no position to press their claim for fees at this time. D & K and G & A are, however, and of all the parties in this case, they present the most compelling case for a fee award. Plaintiff's theories for suing the architect of the new building and the contractor who put it up are, in this Court's opinion, far-fetched. There is no evidence linking either of those parties to the decision to let LMS adapt plaintiff's site plans rather than redo the work from scratch, and no evidence that either of them committed any infringing act. It does not infringe on a surveyor's copyrighted site plan to design a building that will require a revised site plan. And it does not infringe a surveyor's copyrighted site plan for a builder to construct that building from revised site plans that were commissioned and prepared by someone else. Because there is no evidence of copyright infringement by either D & K or G & A, this Court finds that plaintiff's claims against these defendants are objectively unreasonable and awards them reasonable attorneys' fees and costs.

Appendix D

7. Subsequent Proceedings

The Clerk is directed to enter judgment dismissing the complaint in its entirety as to defendants D & K and G & A. Those parties are directed to submit papers in support of the amount of attorneys' fees they claim by September 28, 1999.

Summary judgment is granted in favor of defendants on the Second and Third Causes of Action. Summary judgment is denied on the First Cause of Action. As to the Fourth Cause of Action, the affected parties (plaintiff and the developer defendants) have ten days to submit a letter brief of no more than 3 pages on the issue of preemption. I will issue a follow-up decision in September.

The remaining parties shall prepare and submit a Joint Pre-Trial Order, Proposed Findings of Fact and Conclusions of Law, a Trial Memorandum, Motions *in Limine* (if any), and Witness Statements on Direct by October 29, 1999.

This constitutes the decision and order of the Court.

Dated: August 11, 1999

Colleen McMahon

U.S.D.J

APPENDIX E — OPINION OF THE UNITED STATES DISTRICT COURT FOR THE SOUTHERN DISTRICT OF NEW YORK DATED MAY 14, 1999 AND FILED MAY 17, 1999

UNITED STATES DISTRICT COURT FOR THE SOUTHERN DISTRICT OF NEW YORK

97 Civ. 6270 (CM) (LMS)

ALBERT R. SPARACO, JR.,

Plaintiff,

-against-

LAWLER, MATUSKY, SKELLY ENGINEERS, LLP THOMAS B. VANDERBEEK, NORTHERN METROPOLITAN FOUNDATION, MORRIS KLEIN, DAHN & KRIEGER ARCHITECTS PLANNERS P.C. and GRAHAM & ALEXANDER,

Defendants.

May 14, 1999, Decided

May 17, 1999, Filed

OPINION

REPORT AND RECOMMENDATION

Appendix E

TO: THE HONORABLE COLLEEN MCMAHON, United States District Judge,

Plaintiff, Albert R. Sparaco, Jr., brings this action pursuant to 15 U.S.C. §§ 1051 *et seq.*, (Lanham Act), 17 U.S.C. §§ 101 *et seq.*, (Copyright Act), and invokes the supplemental jurisdiction of the Court, under 28 U.S.C. § 1367, in order to hear his state law claims of unfair competition and breach of contract. This matter has been referred to me, by Order of Reference dated November 18, 1998, for the purpose of issuing a Report and Recommendation on Plaintiff's motion for a preliminary injunction, Defendants' dispositive motions, and Plaintiff's and Defendants' motions for attorneys' fees. The parties have submitted written responses to all of the pending motions, and oral argument was held before me on February 16, 1999. (*See* Transcript, Dkt. # 48.)

BACKGROUND

A. Facts

This is a statement of undisputed facts with all inferences drawn in the light most favorable to Defendants for purposes of the motion for a preliminary injunction, and in the light most favorable to Plaintiff for purposes of the motions to dismiss and for summary judgment. These facts have been gleaned from the statements of the parties, including pleadings, affidavits, and depositions.

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Plaintiff, Albert R. Sparaco Jr., entered into a contract with Defendants Northern Metropolitan Foundation for Health Care, Inc., hereinafter "NMF," and its Executive Director, Morris Klein, hereinafter "Klein," under which Plaintiff was to survey the site for Heritage House,[1] a proposed development. (*See* Contract dated July 15, 1993, attached to Plaintiff's Order to Show Cause, Dkt. # 16, as Exhibit A.) In addition to surveying the site, Plaintiff also created a site plan, consisting of a depiction of the grade and contours of the land, a proposed location for the building, and the proposed location of utilities, for which he obtained a Certificate of Copyright Registration in December, 1996. (*See* Affidavit of Albert Sparaco, sworn to on February 11, 1999, Dkt. # 50, hereinafter "Sparaco Aff.," at ¶¶ 4-10; Amended Complaint, Dkt. # 5, hereinafter "Am. Compl.," Ex. B.) Plaintiff's site plan is dated December 22, 1993. (Am. Compl., Ex. A.) It is undisputed that this site plan was filed with the Town of Ramapo, New York.[2] (Am. Compl. at ¶ 13.)

Klein and NMF hired Defendant Dahn & Krieger, hereinafter "D&K," to redesign the building, in May, 1996. (*See* Affidavit of William Dahn, sworn to on November 25, 1998, attached to Dkt. # 27, hereinafter "Dahn Aff. 1," at ¶ 3; Affidavit of William Dahn, sworn to on February 25, 1999, Dkt. # 47, hereinafter "Dahn Aff. 2," at ¶ 4.) As a result

1. Heritage House is now known as The Fountain View at College Road.

2. Plaintiff asserts that the site plan was filed, but does not provide the actual date of that filing. (Am. Compl. at ¶ 13.) None of the Defendants contradict Plaintiff's assertion.

of the redesign, the footprint of the building changed.[3] (*See* Dahn Aff. 2, at ¶ 6.) As a further result, the site plan prepared by Plaintiff and filed with the Town required amendment. (*See* Dahn Aff. 2, at ¶ 6.)

In 1997, Defendants Klein and NMF contracted with Defendant Lawler, Matusky & Skelly Engineers, LLP, hereinafter "LMS," and one of its partners, Defendant Thomas Vanderbeek, hereinafter "Vanderbeek," to amend the site plan. (*See* Affidavit of Thomas Vanderbeek, sworn to on November 30, 1998, Dkt. # 49, hereinafter "Vanderbeek Aff.," at ¶¶ 3-4.) In completing that project, LMS and Vanderbeek "digitized" contours from Plaintiff's site plan onto the amended site plan, because the land had already been disrupted by the early stages of construction. (*See* Vanderbeek Aff., at ¶ 4.) That amended site plan, by LMS and Vanderbeek, is dated June 13, 1997, and indicates that it is based on a previously approved site plan by Plaintiff. (Am. Compl., Ex. C; Order to Show Cause, Dkt. # 16, Ex. B.) It is undisputed that on July 27, 1997, LMS and Vanderbeek's site plan was also filed with the Town of Ramapo. (*See* Vanderbeek Aff. at ¶ 4.)

Defendants Klein and NMF contracted with Defendant Graham & Alexander, hereinafter "G&A," to construct the building. (*See* Affidavit of Leonard Kohl, sworn to on December 10, 1998, hereinafter "Kohl Aff.," at ¶ 3.) That construction was completed by November, 1998. (*See* Declaration of Morris Klein, at ¶ 3.) LMS and

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3. The footprint of the building is the shape or outline of the building on the surface of the land. (*See* Sparaco Aff., at ¶ 9.)

Vanderbeek are currently in the process of preparing and filing an "as built" survey and site plan. (*See* Affidavit of Thomas Vanderbeek, sworn to on January 22, 1999, hereinafter "Vanderbeek Aff. 2," at ¶ 4, Attached to Dkt. # 40, as Ex. 3.)

Plaintiff filed this action on August 22, 1997, alleging copyright infringement, unfair competition under the Lanham Act, unfair competition under New York law and breach of contract. The claim of breach of contract appears to be alleged as against Defendant Morris Klein alone. In his amended complaint, Plaintiff asserts the following as relevant to all of his claims.

> 15. Some time after Plaintiff Sparaco completed the *Heritage House* Work and it was filed with the Town of Ramapo, New York, Defendants NMF, Klein, D&K, and G&A asked Plaintiff Sparaco to provide an estimate of his services to update the *Heritage House* Work. Upon information and belief, Defendants . . . then decided not to engage Plaintiff Sparaco and, instead, engaged Defendant LMS.
>
> 16. Upon information and belief, after Plaintiff Sparaco published the *Heritage House* Work, Defendants infringed said copyright by copying and causing to be filed in the office of the Clerk of the Town of Ramapo **a derivative work** (hereafter the "Derivative Work") comprising a substantial copy of the *Heritage House* Work."

(Amended Complaint, at ¶¶ 15, 16) (bold emphasis supplied).

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B. Procedural History

Plaintiff's original complaint against LMS and Vanderbeek was filed on August 22, 1997. Plaintiff amended his complaint on November 3, 1997, to include NMF and Klein, architects D&K, and builders G&A. Plaintiff filed an Order to Show Cause why a Preliminary Injunction should not Issue, on April 23, 1998.[4] Defendants responded to that motion, and, subsequently, filed motions to dismiss and for summary judgment, as well as various supporting papers. Defendant Graham & Alexander filed an Affidavit joining in co-defendants' various motions.

DISCUSSION

A. Motions to Dismiss and Motions for Summary Judgment

Defendants LMS, Vanderbeek, NMF, Klein, D&K, and G&A, have all filed dispositive motions as well as motions for attorneys' fees. On November 30, 1998, Defendant D&K filed a cross-motion for summary judgment (Dkt. ## 27, 33, 41, 42, 47), and Defendants LMS and

4. The Motion for Preliminary Injunction and Memorandum of Law were prepared by Plaintiff's counsel in October, 1997. The Honorable Barbara S. Jones, United States District Judge, issued the Order to Show Cause on November 3, 1997. However, these documents were not filed in the Clerk's office until April 23, 1998. Defendants began to respond to the motion in May and June, 1998. The motion has been pending until this time, but since no temporary restraining order was requested during the pendency of the motion, construction of the building continued during this period.

Vanderbeek, (DKT. ## 31, 32, 40, 43, 45), and Defendants NMF and Klein, (Dkt. ## 28, 29, 30, 44, 46), filed motions to dismiss the complaint. Defendant G&A filed an affirmation joining in the motions of code-fendants on December 14, 1998. (Dkt. # 34.) Plaintiff submitted a response to all of these motions on January 14, 1999. (Dkt. # 38). Plaintiff also seeks attorneys' fees.

1. Standard for Motion to Dismiss or for Summary Judgment

When the court is presented with materials outside the pleadings both in support of and in opposition to a Rule 12(b)(6) motion, it is required to either exclude the additional materials and decide the motion solely based on the complaint, or to convert the motion to one for summary judgment under Federal Rule of Civil Procedure 56. The court may convert the motion to dismiss into one for summary judgment after "all the parties [are] given reasonable opportunity to present all material made pertinent to such a motion by Rule 56." *Goyette v. DCA Advertising Inc.*, 830 F. Supp. 737, 741 (S.D.N.Y. 1993) (quoting *In re G. & A. Books Inc.*, 770 F.2d 288, 295 (2d Cir. 1985), *cert. denied*, 475 U.S. 1015 (1986)). In this case, because I have considered materials outside the pleadings, and because all parties have had ample opportunity to respond to all of the motions, I conclude, and respectfully recommend that Your Honor should conclude, that the motions to dismiss submitted by Defendants NMF, Morris Klein, LMS and Vanderbeek, should be deemed to be converted to motions for summary judgment. *See* Fed. R. Civ. P. 12(b), (c).

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2. Standard for Motion for Summary Judgment

Rule 56(c) of the Federal Rules of Civil Procedure provides that summary judgment "shall be rendered forthwith if the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law. "*See, e.g., Cronin v. Aetna Life Ins. Co.*, 46 F.3d 196, 202 (2d Cir. 1995); *see* generally *Celotex Corp. v. Catrett*, 477 U.S. 317, 320-323, 91 L. Ed. 2d 265, 106 S. Ct. 2548 (1986). The standard for summary judgment "provides that the mere existence of some alleged factual dispute between the parties will not defeat an otherwise properly supported motion for summary judgment; the requirement is that there be no genuine issue of material fact." *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 247, 91 L. Ed. 2d 202, 106 S. Ct. 2505 (1986).

The Court's responsibility is to perform "the threshold inquiry of determining whether there is the need for a trial — whether, in other words, there are any genuine factual issues that properly can be resolved by a finder of fact because they may reasonably be resolved in favor of either party." *McNeil v. Aguilos*, 831 F. Supp. 1079, 1082 (S.D.N.Y. 1993), *aff'd*, 107 F.3d 3 (2d Cir. 1996), *cert. denied*, 520 U.S. 1223, 117 S. Ct. 1721, 137 L. Ed. 2d 843 (1997) (quoting *Anderson v. Liberty Lobby, Inc.*, 477 U.S. at 250.) The moving party may rely on the evidence in the record to point out the absence of genuine issues of material fact. *Celotex Corp. v. Catrett*, 477 U.S. 317, 323, 91 L. Ed. 2d 265, 106 S. Ct. 2548 (1986). As noted in Celotex, a motion for summary judgment

"may, and should, be granted so long as whatever is before the district court demonstrates that the standard for the entry of summary judgment, as set forth in Rule 56(c) is satisfied." *Id.*

The responding party must set forth facts showing that there is a genuine issue for trial. Fed. R. Civ. P. 56(e). A summary judgment motion cannot be defeated by speculation or conjecture. *See Pollis v. New Sch. for Soc. Research,* 829 F. Supp. 584, 586 (S.D.N.Y. 1993) (quoting *Western World Ins. Co. v. Stack Oil Inc.*, 922 F.2d 118, 121 (2d Cir. 1990)). Rather, the responding party must show the existence of a disputed material fact in light of the substantive law. *See Liberty Lobby,* 477 U.S. at 248. The responding party must do more than simply show that there is some metaphysical doubt as to the material facts. *See Matsushita Electric Industrial Co. v. Zenith Radio Corp.*, 475 U.S. 574, 586, 89 L. Ed. 2d 538, 106 S. Ct. 1348 (1986).

"In determining whether there is a genuine issue of material fact, a court must resolve all ambiguities, and draw all reasonable inferences, against the moving party." *McNeil v. Aguilos,* 831 F. Supp. at 1082 (quoting *United States v. Diebold, Inc.*, 369 U.S. 654, 655, 8 L. Ed. 2d 176, 82 S. Ct. 993 (1962) (per curiam) and *Donahue v. Windsor Locks Bd. of Fire Comm'rs,* 834 F.2d 54, 57 (2d Cir. 1987)). "Only when no reasonable trier of fact could find in favor of the nonmoving party should summary judgment be granted." *Cruden v. Bank of New York,* 957 F.2d 961, 975 (2d Cir. 1992) (quoting *H.L. Hayden Co. of New York, Inc. v. Siemens Med. Sys. Inc.*, 879 F.2d 1005, 1011 (2d Cir. 1989)).

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3. Copyright Infringement

In his first cause of action, Plaintiff alleges that Defendants "have been copying and making the Derivative Work and, upon information and belief, otherwise selling, and/or otherwise marketing the copyrighted *Heritage House* Work. . . ." (Am. Compl. at ¶ 21.) Plaintiff also alleges that all Defendants have been engaged in this conduct, and that such conduct violates his copyright in the Heritage House plans. Defendants assert that Plaintiff is not entitled to copyright protection because his Heritage House plans lack originality, which is required for copyright protection. Defendants D&K and G&A also argue that they undertook no contractual relationship with Plaintiff Sparaco or with Defendant LMS and took no part in the preparation or filing of the alleged derivative work.

In order to succeed on a claim of copyright infringement,[5] a plaintiff must demonstrate that: "(1) the defendant

5. In his Reply and Opposition (Dkt. 38), Plaintiff alleges that Defendants are liable for copyright infringement based on the theories of vicarious and contributory infringement. A plaintiff, after establishing a case of primary infringement, may also claim that a defendant is liable for contributory infringement of a copyright. A plaintiff may state a claim of contributory infringement against a defendant "who, with knowledge of the infringing activity, induces, causes, or materially contributes to the infringing conduct of another," *Matthew Bender & Company v. West Publishing Co.*, 158 F.3d 693, 706 (2d Cir. 1998), petition for cert. filed, March 18, 1999, (quoting *Gershwin Publ'g Corp. v. Columbia Artists Management, Inc.*, 443 F.2d 1159, 1162 (2d Cir.1971)). Vicarious liability has been defined as "when the right and ability to supervise coalesce

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actually copied the Plaintiff's work; and (2) the copying is illegal because a substantial similarity exists between the defendant's work and the protectible elements of the Plaintiff's work." *Streetwise Maps, Inc. v. Vandam, Inc.*, 159 F.3d 739, 747 (2d Cir. 1998) (internal citations omitted). A certificate of registration from the Copyright Office creates a presumption of validity of the copyright. *See Samara Brothers, Inc. v. Wal-Mart Stores, Inc.*, 165 F.3d 120, 132 (2d Cir. 1998). However, that presumption may be refuted. *Id.* Additionally, "copyright protection may extend only to those components of a work that are original to the author." *Feist Publications, Inc. v. Rural Telephone Service Company, Inc.*, 499 U.S. 340, 348, 113 L. Ed. 2d 358, 111 S. Ct. 1282 (1991); *see also, Streetwise Maps*, 159 F. 3d at 747 ("Because the street locations, landmass, bodies of water and landmarks depicted in a map are physical facts, the only material in a map capable of copyright protection . . . is original material.")

In this case, Defendants assert that Plaintiff's site plan lacks the requisite "originality" in order to receive copyright protection. Defendants maintain that Plaintiff's affirmation of February 11, 1999, demonstrates his "sweat of the brow" in surveying the land and ascertaining various physical facts

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with an obvious and direct financial interest in the exploitation of copyrighted materials." *Peer International Corp. v. Luna Records, Inc.*, 887 F. Supp. 560, 565 (S.D.N.Y. 1995) (internal citations omitted). However, Plaintiff does not allege which Defendants are liable under which theory. Under these circumstances, this Court will not further address this theory.

such as land grades and contours, but does not show any evidence of his creative selection or arrangement of those facts. Defendants also put forward the regulations promulgated by the Town of Ramapo indicating what physical conditions must be depicted on a site plan, and the form of such depictions, in order for such site plan to be accepted by the Town. (*See* Dkt. # 43, Ex. B.) Defendants assert that Plaintiff was constrained by the requirements of the Town of Ramapo as to what physical facts he included and the method by which he depicted such facts, precluding any creativity in selection or arrangement. Rather than demonstrating the absence of a genuine issue of material fact, these arguments establish genuine issues of material fact.[6]

I therefore conclude, and respectfully recommend, that because there exist genuine issues of material fact regarding the factual nature of land grades and contours and Plaintiff's creative selection or arrangement of such conditions, Defendants NMF, Klein, LMS and Vanderbeek's motions for summary judgment should be denied.

In addition to asserting the lack of originality in Plaintiff's site plan, Defendants D&K and G&A also maintain that they took no part in retaining Defendants LMS and Vanderbeek, and took no part in the creation of LMS and

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6. Defendants LMS and Vanderbeek also argue in their response (Dkt. 45) to Plaintiff's affirmation, that Plaintiff performed functions, such as recommending a proposed site for additional utilities that he is not licensed to perform. Defendant argued that Plaintiff should [ILLEGIBLE WORDS] for aspects of the plan that he unlawfully completed. This argument also raises a genuine issue of material fact.

Vanderbeek's site plan. Defendants contend that there is no means by which they can be held liable for any alleged copyright infringement. Plaintiff has shown no evidence demonstrating that D&K or G&A copied, or caused to be copied any portion of Plaintiff's work. Plaintiff points to no contract or instruction between Defendants D&K or G&A and LMS and Vanderbeek. Plaintiff has also presented no evidence that D&K or G&A sold or otherwise marketed the copyrighted *Heritage House* Work. Plaintiff has also failed to allege that Defendants had knowledge of any allegedly infringing activity, or that they directly profited from the infringing activity. I therefore conclude, and respectfully recommend, that Plaintiff's claim of copyright infringement should be dismissed as to Defendants D&K and G&A.

4. Trademark Infringement under the Lanham Act

In his second claim, Plaintiff alleges that by retaining his name on the amended site plan as prepared by Defendants LMS and Vanderbeek, all Defendants "appropriated in substantial part Plaintiff's copyrighted *Heritage House* Work as aforesaid, and held out this Work as the goods of Defendants LMS and Vanderbeek as set forth hereinabove, thereby palming off Plaintiff's *Heritage House* Work as the goods of Defendants LMS and Vanderbeek for the benefit of Defendants." (Am. Compl. at ¶ 24.)[7] The allegedly infringing

7. There is some confusion in the pleadings as to what cause of action Plaintiff is actually alleging. Defendant D&K addresses the claim in terms of infringement, arguing that Plaintiff's name must have achieved secondary meaning in order to be protected as a mark.

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site plan contains the statement "This site plan [is] based on [an] approved plan set entitled 'Heritage House' by A.R. Sparaco, Jr. . . . ," along with a legend at the bottom of the plan, signed by Vanderbeek, indicating that the plan was completed by LMS. (*See* Order to Show Cause, Dkt. # 16, Ex. B; Amended Complaint, Dkt. # 5, Ex. C.) Plaintiff asserts that Defendants intentionally retained Plaintiff's name in order to confuse the public as to the source of the plans. Defendant D&K argues that Plaintiff fails to demonstrate any requirements of a Lanham Act claim. Specifically, D&K asserts that Plaintiff's name is a descriptive term, which requires evidence of secondary meaning in order to be protected under the Lanham Act. D&K also argues that the presence of Plaintiff's name on the amended site plan does not present any likelihood of confusion. Defendants LMS and Vanderbeek argue that they were obligated by New York Education Law § 7209(2) to include Plaintiff's name as the original surveyor.

The relevant portion of the Lanham Act states

(a) Civil action

(1) Any person who, on or in connection with any goods or services, or any container for goods, uses

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Plaintiff does not disagree with this assertion, and responds by contending that his name is distinctive. Plaintiff does refer to Plaintiff's "mark," but only in his argument regarding the third cause of action, which is based on New York trademark law. For reasons stated below, I have addressed Plaintiff's claim primarily as one for false attribution.

> in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which—
>
> > (A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or
> >
> > (B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities, shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

15 U.S.C. § 1125(a). This section of the Lanham Act has been used as the basis for several different kinds of actions. It may be used to protect registered as well as distinctive unregistered marks against infringement. *See Yarmuth-Dion, Inc. v. D'ion Furs, Inc.*, 835 F.2d 990, 992 (2d Cir. 1987). This section also protects against the misrepresentation as to the source or creator of a work. *See Waldman Publishing Corp. v. Landoll, Inc.*, 43 F.3d 775, 780 (2d Cir. 1994); *King v. Innovation Books*, 976 F.2d 824, 828-29 (2d Cir.

1992); *Noble v. Great Brands of Europe, Inc.*, 949 F. Supp. 183, 187-88 (S.D.N.Y. 1996). In order to sustain a claim for infringement under § 1125(a), "a plaintiff must prove (1) that its mark is distinctive and (2) that a likelihood of confusion exists between its product and the defendant's." *Paddington Corp. v. Attiki Importers & Distributors, Inc.*, 996 F.2d 577, 582 (2d Cir. 1993).

This section may also be used to state a claim for false attribution of a creator's work under the theory of false description or representation. 15 U.S.C. § 1125(a); *see King v. Innovation Books*, 976 F.2d 824, 828 (2d Cir. 1992) (citing *Gilliam v. American Broadcasting Companies, Inc.*, 538 F.2d 14, 24-25 (2d Cir. 1976)). Such false or misleading descriptions or representations are actionable if "likely to cause confusion, or to cause mistake, or to deceive. . . ." 15 U.S.C. § 1125(a). "No evidence of public confusion is required where . . . the attribution is false on its face." *King*, 976 F.2d at 829 (citing *PPX Enterprises, Inc. v. Audiofidelity Enterprises, Inc.*, 818 F.2d 266, 272 (2d Cir. 1987)). "However, no false attribution results, and the author accordingly may not object to the use of his [or her] name, if the work, although substantially altered, carries a sufficiently prominent notice indicating which portion in fact was written by others, or if the notice merely indicates truthfully that the work is based on or derived from the work of the author, but does not represent that it is created by or authorized by the author." 2 Nimmer On Copyright, § 8D.03[B][1] (1996).

I conclude, and respectfully recommend, that Plaintiff's allegations in the second claim most closely state a claim for false attribution, rather than infringement.[8] However, since claims under both false attribution and infringement require a showing of likelihood of confusion, the characterization of the claim is somewhat secondary.

Defendants' site plan indicates that it is based on the work of Plaintiff. For Plaintiff to claim that such statement is false, he would have to assert either that Defendants did not appropriate any of his work, or that the LMS site plan is an exact copy of Plaintiff's site plan. Plaintiff does not assert either of these theories. Plaintiff asserts that the attribution is misleading and likely to cause confusion. Defendants have argued that there is no evidence of actual confusion or likely confusion. It is now Plaintiff's obligation to put forth sufficient facts that, if credited at trial, could support a finding of likelihood of confusion. Plaintiff has failed to do so. Indeed, Plaintiff's response to these motions continues to simply assert that confusion is likely to result, but no other facts have been submitted to support that assertion. Therefore, I conclude, and respectfully recommend that Your Honor

8. The second claim in Plaintiff's amended complaint does not assert that his name is a "mark," but rather that the use of his name "is calculated to deceive the public into believing that such good is provided or sponsored by Plaintiff." (Am. Compl. at ¶ 26.) Plaintiff alleges that a work, which was not his creation, is being attributed to him. None of Plaintiff's arguments with respect to the second claim refer to a "mark." However, as noted in footnote 6, *supra*, Plaintiff responds to Defendants' argument that Plaintiff has not established the distinctiveness required by infringement actions by contending that his name is "distinctive."

should conclude, that Plaintiff's claim under the Lanham Act should be dismissed.[9]

5. Unfair Competition under New York law

Plaintiff also alleges, in the third cause of action, that Defendants' inclusion of Plaintiff's name on the amended site plan constitutes unfair competition under New York trademark law. Plaintiff argues that Defendants' inclusion of his name on the amended site plan "is likely to cause confusion as to the source of the goods and to dilute Plaintiff's mark." (Plaintiff's Memorandum in Response, Dkt. # 38, at p. 24.) In support of his claim, Plaintiff cites § 368-d of the New York General Business Law. Section 368-d was repealed effective January 1, 1997. It has been replaced by § 360-1 which is identical in text to the former § 368-d. Plaintiff asserts that § 360-1 does not require a showing of likelihood of confusion in order to find dilution. Defendant

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9. In the event that Your Honor concludes that Plaintiff's allegations do make out a claim for infringement under the Lanham Act, I respectfully recommend that the outcome should remain the same, because, in addition to Plaintiff's failure to demonstrate any likelihood of confusion, Plaintiff has failed to provide any evidence which could support a finding that his name has acquired distinctiveness through secondary meaning.

Plaintiff must demonstrate that his name or corporate name is entitled to protection under the Act, and that Defendants' use of that mark is likely to create consumer confusion. As discussed in detail below, a personal name is considered a descriptive mark requiring a showing of secondary meaning in order receive trademark protection. Plaintiff has failed to put forth any evidence which could establish secondary meaning.

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D&K asserts that, although § 360-1 does not require a showing of confusion, it does require that Plaintiff's mark be distinctive. Section 360-1 provides:

> Likelihood of injury to business reputation or of dilution of the distinctive quality of a mark or trade name shall be a ground for injunctive relief in cases of infringement of a mark registered or not registered or in cases of unfair competition, notwithstanding the absence of competition between the parties or the absence of confusion as to the source of the goods or services.

N.Y. Gen. Bus. Law § 360-1 (McKinney's 1996 & Supp. 1999). A § 360-1 claim requires Plaintiff to demonstrate that his mark "either is of truly distinctive quality or has acquired secondary meaning" and that there is a likelihood of dilution. *See Deere & Co. v. MTD Products, Inc.*, 41 F.3d 39, 42-43 (2d Cir. 1994); *Tri-Star Pictures, Inc. v. Kurt Unger, Leisure Time Productions, B.V.*, 14 F. Supp. 2d 339, 363 (S.D.N.Y. 1998).

"It is well settled that a mark that is 'primarily merely a surname' may not be registered absent a showing of acquired distinctiveness." *Lane Capital Management, Inc. v. Lane Capital Management, Inc.*, 15 F. Supp. 2d 389, 394 (S.D.N.Y. 1998) (quoting 15 U.S.C. § 1052(e)(4)). "Similarly, under the common law, personal names are treated as descriptive terms requiring proof of secondary meaning to receive legal protection." *Id.* (citing *Pirone v. MacMillan, Inc.*, 894 F 2d 579, 583 (2d Cir. 1990)). In this case, Plaintiff's mark, Albert R. Sparaco, Jr., or A.R. Sparaco, is primarily merely

a surname. Plaintiff has failed to offer any evidence that would show any common use of the terms Albert R. Sparaco, or A.R. Sparaco, or Sparaco, other than use as a name.

As Plaintiff's name falls into the category of descriptive marks, Plaintiff must show evidence of secondary meaning in order to show that his mark is distinctive. "Secondary meaning attaches when the name and the business have become synonymous in the mind of the public, submerging the primary meaning of the term in favor of its meaning as a word identifying that business." *Time, Inc. v. Petersen Publishing Company*, 173 F.3d 113, 117, 1999 WL 212260, at *2 (2nd Cir. 1999) (internal citations omitted). Plaintiff has not presented any evidence that, if credited, could support a finding of secondary meaning. Therefore, Plaintiff has failed to demonstrate the distinctive character of his name, and is not entitled to trademark protection for it.

I therefore conclude, and respectfully recommend, that Plaintiff's claim under New York trademark law should be dismissed.

6. Breach of Contract

Plaintiff alleges in his fourth claim that Defendant Morris Klein breached the contract with Plaintiff by using Plaintiff's *Heritage House* work without Plaintiff's written authorization. Defendants NMF and Morris Klein assert that Plaintiff consented to the use Defendants made of his work because the contract specifically authorized Defendants to file the plans for any regulatory purpose. Defendants assert that the amended site plan was filed for a regulatory purpose, and such use was contemplated and authorized by Plaintiff.

Plaintiff asserts that he authorized only the filing of his original site plan, not any amendments or alterations.

Defendants have failed to establish the absence of a genuine issue of material fact with respect to the breach of contract claim. I therefore conclude, and respectfully recommend, that Defendants' motion for summary judgment be denied with respect to this claim.

B. Motion for Preliminary Injunction

Plaintiff, Albert Sparaco, filed an Order to Show Cause why a Preliminary Injunction should not Issue, (Dkt. # 16), as well as a Brief In Support of the Motion, (Dkt. # 17), on April 23, 1998. Defendants LMS and Vanderbeek, filed an Affirmation in Opposition to Plaintiff's Order to Show Cause, (Dkt. # 21), on May 21, 1998. Defendants Northern Metro-politan Foundation and Morris Klein also filed an Opposition to Plaintiff's Motion, (Dkt. # 22), on June 15, 1998. On January 14, 1999, Plaintiff filed his reply, (Dkt. ## 36-38).

Plaintiff seeks a preliminary injunction prohibiting Defendants from infringing upon Plaintiff's copyrighted site plan, including use of a derivative work, requiring Defendants to deliver up and impound all copies of the infringing site plan and all other derivative works including plans, designs, blueprints, prototypes, requiring Defendants to remove or withdraw Plaintiff's name as the surveyor responsible for the site plan or any derivative work which is on file with any governmental agency, and prohibiting Defendants from disparaging, defaming, libeling or misrepresenting the business of Plaintiff.

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Plaintiff seeks not only to enjoin the use of LMS and Vanderbeek's site plan, the only Derivative Work referred to in the amended complaint, but also to enjoin the use of other alleged derivative works, including D&A's architectural plans for the building, and the actual building as constructed by G&A. Plaintiff asserts, in his response memorandum (Dkt. # 38), that these works are based on his site plan. Plaintiff, however, has failed to include these items as alleged derivative works in his amended complaint, despite the addition of D&K and G&A as Defendants. He has also failed to allege how these works have been based on his plan. I therefore conclude, and respectfully recommend that Plaintiff has failed to adequately plead any allegations concerning the architectural plans or the building as derivative works, and that any injunctive relief, if granted, should be limited to the site plans.[10]

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10. However, if Your Honor should find that consideration of injunctive relief should include the architectural plans and the building, I respectfully recommend that Plaintiff has failed to establish the standard required for injunctive relief.

A higher standard for injunctive relief is required when the movant seeks to have a mandatory preliminary injunction imposed. *Tom Doherty Associates, Inc. v. Saban Entertainment, Inc.*, 60 F. 3d 27, 33-34 (2d Cir. 1995) ("we have required the movant to meet a higher standard where: (i) an injunction will alter, rather than maintain, the status quo, or (ii) an injunction will provide the movant with substantially all the relief sought and that relief cannot be undone even if the defendant prevails at a trial on the merits."). A mandatory injunction alters the status quo by requiring some positive act. *Id.* at 34. Here, although couched in terms of a prohibitory act, (i.e., prohibiting Defendants from continuing infringement), I respectfully

(Cont'd)

Appendix E

Defendants LMS and Vanderbeek raise several arguments opposing a preliminary injunction. LMS asserts that Plaintiff's site plan is not material properly copyrighted under the Copyright Act. LMS also contends that any request for injunctive relief is moot as the building and surrounding area has been completed, and as LMS is submitting an "as built" site plan for filing with the Town of Ramapo.[11] Defendants

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(Cont'd)

conclude that the requested relief regarding the architectural plans and the building (which would be demolished) is mandatory in nature, and that Plaintiff must meet a higher standard in order to obtain a preliminary injunction.

The heightened standard requires, in addition to a demonstration of irreparable injury, "[ ] a clear showing that the moving party is entitled to the relief requested, or [that] extreme and very serious damage will result from a denial of preliminary relief." *Tom Doherty*, 60 F.3d at 34 (quoting *Abdul Wali v. Coughlin*, 754 F.2d 1015, 1025 (2d Cir. 1985)). As noted in the main text, Plaintiff's allegations of irreparable injury are, at best, highly speculative. For reasons stated below, I respectfully recommend that such allegations are not sufficient to overcome even the ordinary burden of irreparable injury, and certainly do not satisfy a heightened burden.

11. There have been several assertions that an amended survey and site plan have already been filed with the Town. However, the Affidavit of Thomas Vanderbeek, dated January 22, 1999, attached to Dkt. # 40, states that they have not yet been filed, but are close to being filed. If, indeed, the new survey and site plan have been filed, I respectfully recommend that Plaintiff's request for injunctive relief may be moot at this point. However, since it is my conclusion and recommendation to Your Honor that Plaintiff has failed to establish irreparable injury, my ultimate recommendation that Plaintiff's motion for injunctive relief be denied would not be altered by a finding of mootness.

also argue that Plaintiff has not alleged sufficient facts to support a finding of probable success on the merits, or irreparable injury.

1. Standard for Preliminary Injunction

A preliminary injunction may be granted only upon a showing, by the party seeking the injunction, "(a) that it will suffer irreparable harm in the absence of an injunction and (b) either (i) a likelihood of success on the merits or (ii) sufficiently serious questions going to the merits to make them fair ground for litigation and a balance of hardships tipping decidedly in the movant's favor." *Tom Doherty Associates, Inc. v. Saban Entertainment, Inc.*, 60 F.3d 27, 33 (2d Cir. 1995). "A copyright-infringement action requires the copyright owner to prove copying of a copyrighted work by an infringer." *Kregos v. Associated Press*, 3 F.3d 656, 661 (2d Cir. 1993), *cert. denied*, 510 U.S. 1112, 127 L. Ed. 2d 376, 114 S. Ct. 1056 (1994). "The existence of a prima facie case depends in the first instance on proof by the movant that it is the valid owner of a copyright." *Video Trip Corp. v. Lightning Video, Inc.*, 866 F.2d 50, 52 (2d Cir. 1989). Although Plaintiff has obtained a certificate of copyright registration for the site plan, the validity of that copyright is the very issue that Defendants contest. As there are genuine issues of material fact as to the eligibility of Plaintiff's site plan for copyright protection, I respectfully recommend that a finding of likelihood of success on the merits cannot be made at this point.

In addition to demonstrating likelihood of success on the merits, a party seeking an injunction also must show that

absent the injunctive relief, he or she may suffer irreparable harm. "Irreparable harm must be shown by the moving party to be imminent, not remote or speculative, and the alleged injury must be one incapable of being fully remedied by monetary damages." *Reuters Limited v. United Press International, Inc.*, 903 F.2d 904, 907 (2d Cir. 1990) (internal citations omitted). In cases of copyright infringement, "if probable success a prima facie case of copyright infringement can be shown, the allegations of irreparable injury need not be very detailed, because such injury can normally be presumed when a copyright is infringed." *Wainwright Securities, Inc. v. Wall St. Transcript Corp.*, 558 F.2d 91, 94 (2d Cir. 1977), *cert. denied*, 434 U.S. 1014, 54 L. Ed. 2d 759, 98 S. Ct. 730 (1978). Plaintiff has failed to show even a minimal likelihood of irreparable injury, nor has he shown a lack of adequate remedy at law.

Plaintiff's main contention is that the presence of his name on Defendants' site plan exposes him to liability for any "errors or omissions made in such plans now and into the foreseeable future." (Am. Compl. at ¶ 18.) However, Plaintiff has cited no case holding a surveyor liable in such circumstances. Additionally, there have not been any such errors or omissions identified. Plaintiff's allegations of irreparable injury are pure speculation. Plaintiff's amended complaint also alleges that Plaintiff has been irreparably injured. (Am. Compl. at ¶¶ 27, 31, 36.) Literally interpreted, this would indicate that Plaintiff has suffered his injury already, not that he is likely to be injured should Defendants not be enjoined. What is also significant is that Plaintiff delayed the filing of this motion for preliminary injunction for several months, despite the Order to Show Cause having

been signed by the Honorable Barbara S. Jones in November, 1997. The site plan in question, however, remained filed, and construction of the site continued during that time.

Plaintiff has failed to show either that there is a likelihood of success on the merits, or that he will suffer irreparable harm if the injunction does not issue. There is no attempt to satisfy the alternative prong of sufficiently serious question going to the merits. For those reasons, I conclude, and respectfully recommend, that Plaintiff's motion for a preliminary injunction should be denied at this time.

C. Cross Motions for Attorneys' Fees

Plaintiff and Defendants all assert that they are entitled to attorneys' fees as the "prevailing party." I respectfully conclude that the determination of whether any party has "prevailed" at this stage of the proceedings cannot be made until Your Honor has reviewed this Report and Recommendation. Therefore, I conclude, and respectfully recommend, that the motions for attorneys' fees should be denied at this time.

Appendix E

CONCLUSION

In summary, I conclude and respectfully recommend that Defendants' motions for summary judgment should be granted in part and denied in part. Specifically, with respect to Plaintiff's first claim for copyright infringement, I recommend that Defendants NMF and Klein and LMS and Vanderbeek's motions should be denied, and that Defendants D&K and G&K's motions should be granted. I recommend that all Defendants' motions with respect to the second claim alleging violations of the Lanham Act, and the third claim alleging New York trademark law violations should be granted. I also recommend that Defendant NMF and Morris Klein's motion with respect to the fourth claim alleging breach of contract should be denied.

Regarding Plaintiff's motion for a preliminary injunction, I conclude and respectfully recommend that Plaintiff has failed to show either likelihood of success or irreparable injury, and the motion should be denied. Finally, with respect to the motions for attorneys fees, I respectfully recommend that the motions be denied at this time, with leave to replead pending the outcome of Your Honor's review of this Report and Recommendation.

Dated: May 14, 1999

White Plains, New York

Respectfully Submitted,

LISA MARGARET SMITH

United States Magistrate Judge

APPENDIX F — ORDER OF THE UNITED STATES COURT OF APPEALS FOR THE SECOND CIRCUIT DENYING PETITION FOR REHEARING DATED AND FILED OCTOBER 25, 2002

UNITED STATES COURT OF APPEALS
FOR THE SECOND CIRCUIT
United States Court House
40 Foley Square
New York 10007

ROSEANN B. MACKECHNIE
CLERK

At a stated term of the United States Court of Appeals for the Second Circuit, held at the United States Courthouse, Foley Square, in the City of New York, on the day 25th of October two thousand two.

Dkt Nos: 99-9519 (L), 01-9199 (CON), 01-9289 (XAP)

Sparaco,

Plaintiff-Appellant-Cross-Appellee,

v.

Lawler, Matusky, et al.,

Defendants-Appellees-
Cross-Appellants,

Dahn & Krieger, et al.,

Defendants-Appellees.

Appendix F

A petition for panel rehearing and a petition for rehearing en banc having been filed herein by the plaintiff-appellant cross-appellee Sparaco.

> Upon consideration by the panel that decided the appeal, it is Ordered that said petition for rehearing is **DENIED.**

It is further noted that the petition for rehearing en banc has been transmitted to the judges for the court in regular active service and to any other judge that heard the appeal and that no such judge has requested that a vote be taken thereon.

FOR THE COURT

ROSEANN B. MACKECHNIE, Clerk

By: s/ Arthur M. Heller by LBP
Arthur M. Heller,
Administrative Attorney